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In the Supreme Court of the United States

OCTOBER TERM, 1940.

No. .....

KENNETH S. CLAPP,
Plaintiff-Petitioner,

vs.

STEWART-WARNER CORPORATION,
Defendant-Respondent.

PETITION FOR WRIT OF CERTIORARI.

To the Honorable, the Chief Justice and Associate Justices of the Supreme Court of the United States:

Your petitioner, Kenneth S. Clapp, prays for a writ of certiorari to the United States Circuit Court of Appeals for the Seventh Circuit, to review:

(1) the decision of December 5, 1940 of that Court (R-II 1039, and reported at 116 Fed. 2nd 68, a copy being included as an appendix to the attached Brief in support of this Petition)

(2) the judgment of the Court entered December 5, 1940 (R-II 1046), holding the plaintiff-petitioner's Baldner patent No. 1,570,032 not infringed by the manufacture, use and sale of defendant-respondent's grease-dispensing apparatus.

The decision of the said Seventh Circuit Court of Appeals in the case at bar is in conflict with the decisions of this Court upon two fundamental and well established principles of patent law. The two conflicting grounds are:

First Conflicting Ground: The decision of the Seventh Circuit Court of Appeals is in direct conflict with the decisions of this Court in the case of *Rogers vs. Alemite* (298

U. S. 415) and in the case of *Lincoln vs. Stewart-Warner* (303 U. S. 545), involving the defendant-respondent's patents upon grease-hose couplers usable with the grease-dispensing apparatus here in suit, and presenting parallel facts concerning the same general type of greasing equipment and its use and the same legal situation as in the case at bar, and deciding the same question of patent law as is involved in the present case at bar.

Second Conflicting Ground: The decision of the Seventh Circuit Court of Appeals is in direct conflict with the decisions of this Court in the case of *Continental Paper Bag Co. vs. Eastern Paper Bag Co.* (210 U. S. 405), the case of *Leeds and Catlin vs. Victor Talking Machine Co.* (213 U. S. 301), the case of *Altoona Theaters vs. Tri-Ergon Corp.* (294 U. S. 477) and other cases, deciding the same question of patent law as is involved in the present case at bar.

A transcript of record of the case at bar, including the proceedings in the said Seventh Circuit Court of Appeals, is furnished herewith in accordance with Rule 38 of the Rules of this Court.

SUMMARY AND SHORT STATEMENT OF MATTER INVOLVED.

First Conflicting Ground:

The present defendant-respondent, Stewart-Warner Corporation, was also before this Court in the case of *Lincoln vs. Stewart-Warner* (303 U. S., 545) and also in the case of *Rogers vs. Alemite Corp.* (298 U. S. 415), under the names of its wholly owned subsidiary and its predecessor, Alemite Corporation and Bassick Mfg. Co.

In the said case of *Lincoln vs. Stewart-Warner* the decision reviewed and reversed by this Court was that of the Circuit Court of Appeals for the Seventh Circuit and in the case at bar the decision of which review and reversal is sought is also that of the said Circuit Court of Appeals

for the Seventh Circuit, upon grounds which are the *same* as those upon which the said Court of Appeals was reversed by this Court in *Lincoln vs. Stewart-Warner* (303 U. S. 545). Both the present case and the *Lincoln vs. Stewart-Warner* case involved lubricating equipment. In the present case, the invention relates to a large grease-compressor or pump for pumping grease through a conduit or hose. In the *Lincoln vs. Stewart-Warner* case the subject matter of the invention related to the small coupler, attached to the end of the hose, for quick connection to the fitting of the automobile or machinery bearing.

The Seventh Circuit Court of Appeals in the *Lincoln vs. Stewart-Warner* case held that claims drawn to include a long list of aggregative parts of an old grease-compressor, old hose, improved coupler, and old fitting on an automobile, were proper and permitted a monopoly upon that old aggregation. This Court thereupon completely reversed the Seventh Circuit Court of Appeals in its decision of *Lincoln vs. Stewart-Warner* and stated that such claims to the old aggregation were invalid as attempting to unlawfully monopolize more than that which was invented, and stated that claims must be confined to that part of the equipment in which the invention resided;—in that case, the coupler.

Completely unmindful of its reversal in the *Lincoln vs. Stewart-Warner* case, the Seventh Circuit Court of Appeals has, in the case at bar, *required* that claims *must* be drawn to include a long list of old aggregative parts consisting of a hose, coupler and fitting with an improved grease-compressor, in order to protect the invention residing *solely* in the improved grease-compressor. To exonerate the accused grease-compressors from the charge of infringement the Court of Appeals pointed out that the accused grease-compressors are *always sold and used with a hose and coupling* adapted to be attached to a fitting, but that inasmuch as the patent claims did not include a

catalogue of a listing of these additional old parts of hose, coupler or other extraneous part, there was no infringement. In other words, the claims in suit being directed to the grease-compressor *per se* and being admittedly valid,* were held not infringed for the reason that the claims are confined to the grease-compressor, (the lawful scope of the invention) rather than to the aggregative parts of the grease-compressor, the hose, the coupler, and the fitting (the unlawful monopoly), as this Court held the claims should be so confined by its reversal and mandate to the Seventh Circuit Court of Appeals in the *Lincoln vs. Stewart-Warner* case. The plaintiff-petitioner has been penalized because the patent is in accordance with the law enunciated by this Court rather than in conformity with the overruled decision of the Seventh Circuit Court of Appeals.

The said Seventh Circuit Court of Appeals, in the decision of which review is here sought, has thus persisted in the same error and the same mistaken view of a fundamental and well established principle of patent law for which it was reversed by this Court in said case of Lincoln vs. Stewart-Warner.

The plaintiff-petitioner is the owner of the Baldner patent in suit (R-II 661, 1040), and is general manager of the U. S. Air Compressor Company, of Cleveland, Ohio, manufacturers of automobile service station equipment such as air compressors, car lifts, car washers, and grease-dispensing machines or so-called "grease guns," for the manufacture of which it is licensed under defendant-respondent's so-called "Alemite" coupler patents (R-I 26, 463).

The Baldner patent (R-II 680) discloses a novel combination of elements comprising a new kind of power driven grease-dispensing machine, grease-compressor, pump or so-called grease-gun which is the subject-matter of Baldner

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* Found valid by the Court of Appeals (R-II 1046).

claims 2, 3, 4 and 13 in issue. In the Courts below the defendant-respondent's power driven grease-dispensing machine was referred to by its trade name of "Rock Crushers."

As this Court said in *Rogers vs. Alemite* (298 U. S. 415) grease-dispensing machines, compressors, pumps or grease-guns are generally "old in the art," and as this Court said in *Lincoln vs. Stewart-Warner* (303 U. S. 545) the function of grease-dispensing machines, compressors, pumps or grease-guns "has always been to force a fluid or grease through a conduit." There were different types, kinds and constructions of grease-dispensing machines made and patented prior to the Baldner patent in suit. Nevertheless, Baldner was the *first* one to invent a two-stage grease-dispensing machine or grease-gun in which an impositive-displacement screw-conveyor continuously feeds grease from a reservoir to a positive-displacement intermittent booster or pump positively inter-geared therewith, at a rate-of-feed *greater* than the displacement rate of the booster;—to the end that, upon the intake stroke or movement of the piston, the chamber of the booster is *completely filled* at each and every stroke (instead of becoming "air-bound") and that, upon the discharge stroke or movement of the piston, the discharged grease is ejected from the booster or pump in a *uniform and continuous* flow (instead of spasmatic spluttering with air pockets or instead of ceasing to flow altogether).

A positive-displacement type of pump, ejector or booster, is one having a cylinder or chamber of fixed dimensions in which operates a close fitting piston or ejecting member having a recurring cycle or alternating intake and ejecting movements. The piston or ejecting member may be of two types, (1) the rotary-piston or vane type or (2) the reciprocatory type of piston. It is admitted in the Record (R-I 229) that both types are equivalent. In a positive-displacement pump or ejector, the cylinder or

chamber is not in constant communication with the source of grease supply but is in communication with the source of grease supply only at regularly recurring intervals during what is commonly called the "intake" movement or stroke, during which a small amount of grease is transferred to the cylinder or chamber, whereupon the communication with the source of grease supply is shut off and all of the grease which has therefore been entrapped in the pump chamber or cylinder is thus entirely separated or divorced from the source of the grease supply and is ejected by the piston or ejector upon the exhaust or discharge stroke or movement. Upon each successive discharge stroke or movement of the piston, the grease is divided into charges of a fixed or known quantity determined by the size of the pump chamber or cylinder. A positive-displacement pump or ejector, in positively advancing or ejecting grease, is distinguishable from an impositive pump or ejector, such for example, as a screw-conveyor which permits the grease to leak back when the forward end of the screw conveyor is closed or dammed.

The prior art of record shows a few single-stage and two-stage grease-dispensing machines but none of these embody the Baldner invention in which the grease is *initially* engaged by a power-driven screw conveyor (impositive feed) which advances or feeds the grease to a *positive*-displacement type pump, ejector or so-called "booster" which finally ejects or discharges the grease through a conduit or hose. In the Baldner device, the screw conveyor is inter-geared and power driven in unison with the booster pump and feeds the grease to the booster pump at a rate in *excess* of the pumping rate of the booster and packs or presses the grease, free of air pockets or spaces, at the entrance to the booster to assure, upon each suction stroke, the quick and *complete* filling of the pumping chamber of the booster with solid grease devoid of air pockets. Accordingly, upon each pumping or ejecting

stroke the grease is discharged in a solid stream. The foregoing may be summarized by quoting from lines 43 to 47 of the Baldner patent (R-II 683) which reads:

> "A further object of the invention is to provide in conjunction with the dispensing apparatus, a 'booster' or auxiliary ejector or pump to insure *uniform and continuous discharge.*"

Claims 2, 3, 4 and 13 of the Baldner patent in suit are admittedly valid* and therefore define a patentable invention which is new and useful in the art. No prior art was set up by the Court of Appeals to restrict them in any way. The said claims 2, 3, 4 and 13 are confined to the described Baldner two-stage grease-dispensing machine *per se* and comply fully with the principle set forth by this Court in the *Lincoln vs. Stewart-Warner* case, and do not include extraneous elements or the environment with which the grease-dispensing machine may be used.

The Baldner patent shows a conduit or hose leading from the discharge outlet of the positive-displacement booster pump (conduit 23 of figure 1 and referred to in lines 53-54 and 112 of page 2 of the Baldner patent, R-II 684) but does not go into a detailed description or elaborate exposition of what occurs *after* the grease is discharged or ejected by the two-stage grease-dispensing machine *per se.* The Baldner specification sets forth that the piston or rotary vane in the booster chamber **forcibly** ejects or advances the grease (R-II 684). The specification does not go on to explain the elemental and well known physical fact that the pressure of the discharged grease after ejectment is dependent upon the *external factor of resistance* outside of the machine itself. That is, if the grease is discharged freely into the open and meets no resistance there is little or no pressure built up in the grease. This may

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* The Circuit Court of Appeals found the patent and claims in suit valid and refused to apply any prior art to anticipate or restrict the claims in any degree. (R-II 1046.)

be characterized as the "free flow" condition. On the contrary, if an external resistance is set up to the flow of the discharged grease, such as the resistance made by a restricted hose of small bore, or by a closed nozzle or valve, or by a "frozen" or dirty automobile bearing with which the hose may be connected, then a pressure will be built up in the grease hose.

This elemental fact that pressure of the grease is dependent upon the external factor of resistance is uncontroverted and was so found by the Court of Appeals in describing the accused "Rock Crusher" two-stage grease dispensing-machine, as for example, in the following language:

> "Continued operation of the motor will pump grease through the hose into the fitting through which the automobile bearing is lubricated. *If** the moving lubricant meets with *resistance* because of dirt, rust or dried grease in the fitting or bearing, the motor will compress the grease until the resistance is overcome, the machines being capable of building up grease *pressure* of more than five thousand pounds per square inch." (R.-II 1044.)

The Baldner grease-dispensing machine also was capable of building up grease pressure of more than five thousand pounds per square inch. On actual demonstration in court the Baldner machine produced a higher pressure than the defendant-respondent's machine, reaching **7000** pounds pressure per square inch. (R-I 224.)

Following the well established principle of proper claim drafting so clearly enunciated by this Court in *Lincoln vs. Stewart-Warner* (303 U. S. 545) the Baldner patent did not include in the claims in suit the well known hose, coupler, fitting, automobile bearing or any other extraneous element outside of the invented machine, and of course did not include the resultant pressure which may be produced

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* All emphasis throughout is our own unless otherwise indicated.

in the discharged grease meeting the resistance of the hose, coupler, fitting, automobile bearing or other extraneous element. For Baldner to have included in claims 2, 3, 4 and 13, the hose, the coupler or the fitting would have been to incorporate into the claim more than he invented and would have been in direct contradiction to this Court's admonition in *Lincoln vs. Stewart-Warner* against claiming an aggregation of well known elements.

In spite of the decision in the *Lincoln vs. Stewart-Warner* case, the Seventh Circuit Court of Appeals reverted back to its old erroneous position and exonerated the Defendant-Respondent's accused machine on the grounds that:

> "They (the accused 'Rock Crushers') are always *sold and used* with a delivery hose attached, the hose being fitted at its forward end with a coupler by which it is attachable to the lubricant fitting" (R-II 1044)

and are

> "adapted to deliver grease through a hose conduit to automobile lubricant fittings, where grease is delivered to bearings under pressure of five thousand pounds and higher, per square inch." (R-II 1043.)

This ruling that the "Rock Crushers" escape from the scope of the claims in suit because the claims do not include the hose, coupler and fitting and the pressure of the grease encountering the resistance offered by the hose, coupler and fitting, is in direct contravention and opposition to this Court's decisions in *Rogers vs. Alemite* (298 U. S. 415) and *Lincoln vs. Stewart-Warner* (303 U. S. 545).

The Seventh Circuit Court of Appeals has therefore penalized the plaintiff-petitioner because the Baldner claims in suit are fully in accord with what this Court said patent claims should be; or stated in the reverse, because the Baldner claims avoid that which this Court said they should avoid, in its decisions in the case of Rogers vs. Alemite (298 U. S. 415) and the case of Lincoln vs. Stewart-Warner (303 U. S. 545).

Second Conflicting Ground:

Baldner's patent specification besides showing, describing and claiming his power driven two-stage grease-dispensing machine *also* shows and describes a small meter, dial or gauge and an electrical switch-controlling circuit which may be optionally superimposed upon the grease-dispensing machine, in order to indicate or register the total amount of grease dispensed or delivered by the grease-dispensing machine.

In other words, the Baldner specification not only showed and described his novel two-stage grease-dispensing machine or "grease-gun" but also showed and described a tachometer to *count* the number of cycles or strokes of his booster pump.

The counting-dial and electrical controlling circuit in the Baldner specification are *not* included in claims 2, 3, 4 and 13 in suit but are the subject matter of *other* claims not in suit. There has been no charge that the defendant-respondent has used the small meter, dial or gauge, or the electrical control circuit which are disclosed in the patent specification. The charge of infringement is directed to the large grease-dispensing machine, *per se.* The Baldner grease-dispensing machine and the defendant-respondent's machines are structurally equivalent. The parts of one machine are readily interchangeable with corresponding parts of the other machine. The Court of Appeals in its opinion (R-II 1039) described the structures of both the patented machine and the accused machine and found *no distinction* in the structural elements of the machines *per se.* The patent claims in suit cover or "read on" the accused "Rock Crushers," as all the elements in the claims are found in the accused devices. In addition, the Seventh Circuit Court of Appeals failed to find any pertinent prior art which would anticipate or restrict the scope of the Baldner claims in suit. Therefore, the present status of the claims in issue is that they are valid and are unrestricted by any prior art.

Notwithstanding the fact that (1) the Baldner claims in suit are valid and unrestricted by the prior art, (2) the Baldner machine and the accused machine are mechanical equivalents, and (3) the claims in suit "read on" the accused machine, element for element, the Seventh Circuit Court of Appeals exonerated the accused "Rock Crushers" upon the erroneous ground that the "entire specification" is the measure for the patented invention rather than the claims and that the patent does not protect from infringement anything other than the "entire combination" disclosed in the "entire specification." The Court of Appeals disregarded the claims in suit and took the "entire specification" as the measure of the patent, contrary to the principle repeatedly enunciated by this Court in the case of *Continental Paper Bag Co. vs. Eastern Paper Bag Co.* (210 U. S. 405), the case of *Leeds and Catlin vs. Victor Talking Machine Co.* (213 U. S. 301), the case of *Altoona Theaters vs. Tri-Ergon Corp.* (294 U. S. 477) and other cases. The Circuit Court of Appeals excused the "Rock Crushers" from infringement in the following language:

> "These 'Alemite Rock Crushers' are never sold as *metering* or measuring devices, and could not be so used. * * * There is *no meter or gauge* of any kind *included* in the structure which is used or usable to measure the quantity of grease discharged, and in lubricating a car there is *no way of knowing* how many cubic inches of lubricant may be used." (R-II 1044.)
>
> "Assuming without conceding that the accused structures, *so far as they go,* use precisely the *same means* as the patent uses, yet appellee could not be held for infringement, for Baldner has *no patent* on anything *less* than his *entire combination.*" (R-II 1046.)

This ruling that the accused "Rock Crushers" avoid the charge of infringement because they do not include a meter, gauge or other counting or indicating mechanism, was made in face of the fact that the claims in suit do not

include nor attempt to include, nor has it been asserted or found that they do include, any such meter, gauge or other counting or indicating mechanism, as for example claim 3 of the patent:

> "3. In an apparatus of the character described, a reservoir, an ejector communicating therewith dividing the discharged material into successive charges of known capacity and conveyor means for supplying the material to the ejector in quantity greater than its capacity whereby said ejector will act to impede the normal flow of the material under influence of the first ejector and will be operated at full capacity to discharge the material in known measured quantity."

The Seventh Circuit Court of Appeals has therefore erroneously deprived the plaintiff-petitioner of protection as against infringement of the Baldner two-stage grease-dispensing machine described and covered by claims 2, 3, 4 and 13 in suit, even though Baldner fully complied with the patent statute that "he shall particularly point out and distinctly *claim* the part, improvement, or combination which he claims as his invention or discovery"* and despite the expressed law laid down by this Court that it is the *claims* of a patent which measure the invention and the scope of the patent monopoly.

The Circuit Court of Appeals by thus erroneously insisting that the "entire specification" measures the patented invention rather than the claims, has made a ruling directly contrary to the patent statutes and completely opposed to the applicable decisions of this Court in the cases of Continental Paper Bag Co. vs. Eastern Paper Bag Co. (210 U. S. 405); Leeds and Catlin vs. Victor Talking Machine Co. (213 U. S. 301); Altoona Theaters vs. Tri-Ergon Corp. (294 U. S. 477) and many other decisions of this Court.

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* Quoted from Section 4888 of the Revised Statutes (U. S. C. Title 35, Sec. 33).

A summary of this case is graphically shown in the drawing inserted immediately following this Statement. The large central body of the drawing illustrates the Baldner two-stage grease-dispensing machine and the equivalent "Rock Crusher" two-stage grease-dispensing machine.

The color scheme applied to this drawing is the same as that adopted in the exhibits in the Courts below. The color *green* has been applied to grease in the main reservoir (and in the communicating passageways) solely under the influence of the screw conveyor initially advancing the grease. The color *purple* has been applied to the walls of the pump or "booster" chamber which is of fixed volumetric capacity. The color *red* has been applied to the ejecting-piston of the pump or "booster." The color *blue* has been applied to the grease which has been separated or "divorced" from the main (*green*) body of grease by the ejecting piston (*red*) and which is forced out through the hose or conduit solely under the influence of the ejecting piston (*red*).

Extending from the sides of the central main drawing are appendages upon which are illustrated the subject matter to which the Court of Appeals devoted its discussion.

The appendage extending adjacent the "Rock Crusher" machine illustrates the subject matter covered by the portion of this Statement, entitled: "First Conflicting Ground" and shows a hose, coupler and automobile fitting. The Court of Appeals held that since the "Rock Crusher" machines "are always sold and used with a delivery hose attached, the hose being fitted at its forward end with a coupler by which it is attachable to the lubricant fitting" there is no infringement because the claims in suit do not include a hose, coupler and automobile fitting.

The appendage extending adjacent the Baldner machine illustrates the subject matter covered by the portion of this Statement, entitled: "Second Conflicting Ground" and shows the gauge, meter or dial. The Court of Appeals

held that since "there is no meter or gauge of any kind included in the structure" of the "Rock Crusher" grease-dispensing machine there is no infringement, even though the claims in suit do not mention such a meter or gauge of any kind.

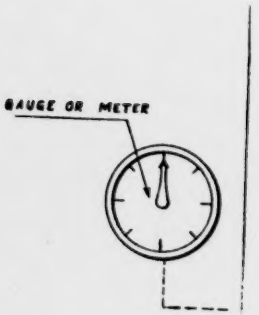
EXAMPLE CLAIM 3 OF BALDNER PATENT:

3. "In an apparatus of the character described, a reservoir, an ejector communicating therewith dividing the discharged material into successive charges of known capacity and conveyor means for supplying the material to the ejector in quantity greater than its capacity whereby said ejector will act to impede the normal flow of the material under influence of the first ejector and will be operated at full capacity to discharge the material in known measured quantity."

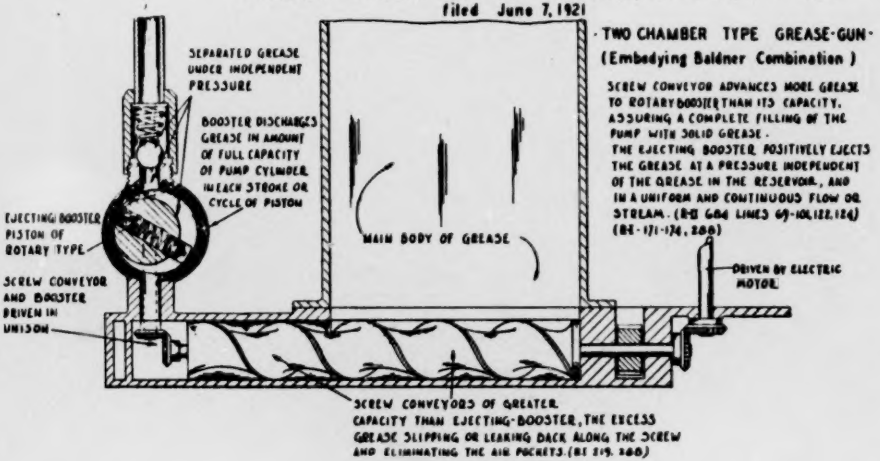
COVERS BOTH GREASE-COMPRESSORS:

APPENDAGE.

Old Hose, Old Coupler, and Old Fitting Not Included In Claims On Improved Grease-Compressor Under Authority of Lincoln vs. Stewart-Warner (303 U. S. 545) and Rogers vs. Alemite (298 U. S. 415).



BALDNER PATENT IN SUIT NO. 1,570,032 (R-II 680-I-478)
filed June 7, 1921



· TWO CHAMBER TYPE GREASE-GUN ·
(Embodying Baldner Combination)

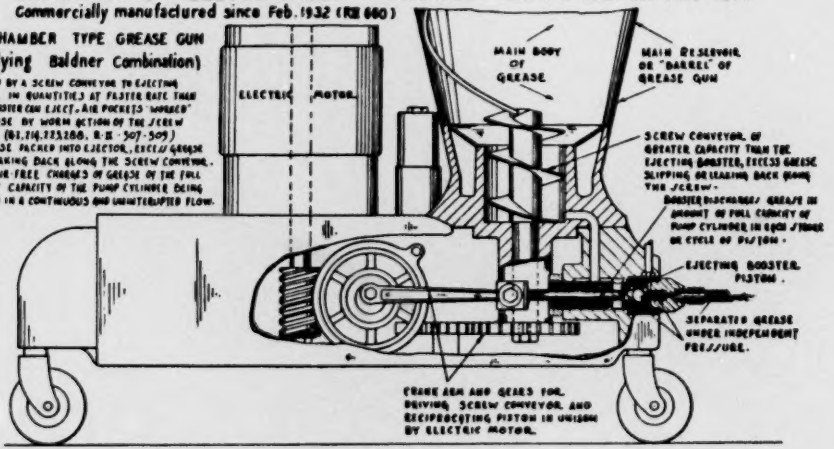
SCREW CONVEYOR ADVANCES MORE GREASE TO ROTARY BOOSTER THAN ITS CAPACITY, ASSURING A COMPLETE FILLING OF THE PUMP WITH SOLID GREASE.
THE EJECTING BOOSTER POSITIVELY EJECTS THE GREASE AT A PRESSURE INDEPENDENT OF THE GREASE IN THE RESERVOIR, AND IN A UNIFORM AND CONTINUOUS FLOW OR STREAM. (R-II 684 LINES 69-101, 122, 124) (BE-171-174, 288)

DEFENDANT'S ELECTRICALLY OPERATED ROCK CRUSHER (R-I-481)

Commercially manufactured since Feb. 1932 (RX 660)

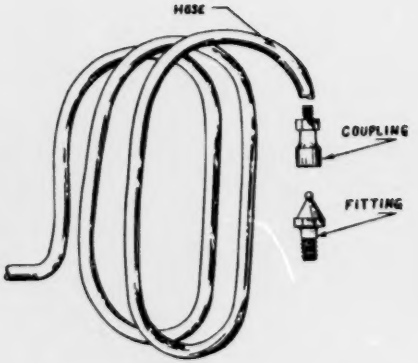
TWO CHAMBER TYPE GREASE GUN
(Embodying Baldner Combination)

GREASE FED BY A SCREW CONVEYOR TO EJECTING BOOSTER IN QUANTITIES AT FASTER RATE THAN EJECTOR BOOSTER CAN EJECT, AIR POCKETS "WORKED" OUT OF GREASE BY WORM ACTION OF THE SCREW CONVEYOR. (81,714,225,288, R-II-507-509) SOLID GREASE PACKED INTO EJECTOR, EXCESS GREASE AND AIR LEAKING BACK ALONG THE SCREW CONVEYOR. SOLID AND AIR-FREE CHARGES OF GREASE OF THE FULL VOLUMETRIC CAPACITY OF THE PUMP CYLINDER BEING DISCHARGED IN A CONTINUOUS AND UNINTERRUPTED FLOW.



APPENDAGE.

Gauge or Meter Not Included In Baldner Claims 2, 3, 4 and 13 In Suit. Claims Measure the Invention: Continental Paper Bag Co. vs. Eastern Paper Bag Co. (210 U. S. 405); Leeds and Catlin vs. Victor Talking Machine Co. (213 U. S. 301); and Altoona Theaters vs. Tri-Ergon Corp. (294 U. S. 477).



REASONS RELIED UPON FOR ALLOWING WRIT OF CERTIORARI AND QUESTIONS PRESENTED.

The judicial discretion of this Court is invoked on the grounds of the following special and important reasons:

(1) The Circuit Court of Appeals for the Seventh Circuit has rendered an erroneous decision in the case at bar, in direct conflict with the decisions of this Court in the case of *Rogers vs. Alemite* (298 U. S. 415) and the case of *Lincoln vs. Stewart-Warner* (303 U. S. 545) upon the same matter; namely, the statutory requirement and legal right of a patentee to confine his patent claims to an improved grease-compressor *per se* wherein his invention resides, rather than including in his claims the old elements of a hose, coupler and fitting with which grease-compressors have long been used.

The **question** presented by this conflict is whether a patentee shall be penalized and deprived of patent protection because his unanticipated and admittedly valid patent claims are confined to the vital and invented part or improvement constituting the real invention as demanded by the patent statutes and as required and insisted upon by this Court in the cases of *Rogers vs. Alemite* and *Lincoln vs. Stewart-Warner.*

(2) The Circuit Court of Appeals for the Seventh Circuit has rendered an erroneous decision in the case at bar upon a vitally important point of patent law, in direct conflict with the following applicable decisions of this Court holding that the claims of a patent define and measure the patented invention and the scope of the patent monopoly rather than the "entire specification":

Continental Paper Bag Co. vs. Eastern Paper Bag Co., 210 U. S. 405;

Leeds and Catlin vs. Victor Talking Machine Company, 213 U. S. 301;

Altoona Theaters vs. Tri-Ergon Corporation, 294 U. S. 477;

Smith vs. Snow, 294 U. S. 1;
Cimiotti Unhairing Co. vs. American Fur Refining Co., 198 U. S. 399;
Merrill vs. Yeomans, 94 U. S. 568;
Railroad Co. vs. Dubois, 79 U. S. (12 Wall.) 47;
Seymour vs. Osborne, 78 U. S. (11 Wall.) 516;
White vs. Dunbar, 119 U. S. 47;
Hogg et al. vs. Emerson, 52 U. S. (11 How.) 587;
Motion Picture Co. vs. Universal Film Co., 243 U. S. 502;
Railroad Co. vs. Mellon, 104 U. S. 112.

The **question** presented by this conflict is whether a patentee who has complied with the statutory requirement to "particularly claim the part, improvement, or combination which he claims as his invention or discovery" * and who has claims which are unanticipated and admittedly valid and which constitute the measure of the invention and patent monopoly under the above decisions of this Court, shall be penalized and deprived of patent protection upon the claimed invention simply because the specification of his patent in addition to describing his claimed invention also describes other parts or features with which his claimed invention may or may not be used as desired.

WHEREFORE, your petitioner respectfully prays that a Writ of Certiorari be issued under the seal of this Court, directed to the United States Circuit Court of Appeals for the Seventh Circuit sitting at Chicago, Illinois, commanding said Court to certify and send to this Court, on a date to be designated, a full and complete transcript of the record and all proceedings of the Circuit Court of Appeals had in this cause, to the end that this cause may be reviewed and determined by this Court, and that the judgment of the Circuit Court of Appeals for the Seventh Circuit may

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* Quoted from Section 4888 of the Revised Statutes (U. S. C. Title 35, Sec. 33).

be reversed and that your petitioner may be granted such other and further relief as may seem proper.

KENNETH S. CLAPP,

By BRUCE B. KROST,

Counsel for Petitioner.

The undersigned hereby certifies that the foregoing petition is in his opinion well-founded, and that the case is one in which petitioner's prayer should be granted by this Court.

BRUCE B. KROST,

Counsel for Petitioner.

In the Supreme Court of the United States

OCTOBER TERM, 1940.

No. .....

KENNETH S. CLAPP,
Plaintiff-Petitioner,

vs.

STEWART-WARNER CORPORATION,
Defendant-Respondent.

BRIEF FOR PETITIONER IN SUPPORT OF PETITION FOR WRIT OF CERTIORARI.

To the Honorable, the Chief Justice and Associate Justices of the Supreme Court of the United States:

OPINIONS OF THE COURTS BELOW.

The Opinion of the Circuit Court of Appeals for the Seventh Circuit, on the appeal in the case at bar, is reported at 116 Fed. 2nd 68 and is included in the Transcript of Record (R-II 1039, a copy also being attached as an appendix to this brief).

The Oral Opinion of the District Court for the Northern District of Illinois is included in the Transcript of Record (R-II 664), and the Findings of Fact and Conclusions of Law entered by the District Court are also included in the Transcript of Record (R-II 650-663).

JURISDICTION.

The grounds on which the jurisdiction of this Court is invoked, are:

1. The date of the judgment to be reviewed was December 5, 1940. (R-II 1046.)

2. The judgment was rendered in a suit in equity brought under the Patent Statutes to determine the issues of validity and infringement of letters patent for invention issued by virtue of Section 4886 (U. S. C. Title 35, Sec. 31) and Section 4888 (U. S. C. Title 35, Sec. 33) of the Revised Statutes of the United States.

3. The statute under which jurisdiction is invoked is Section 240 (a) of the Judicial Code (U. S. C. Title 28, Sec. 347).

4. Cases sustaining jurisdiction are:

Lincoln vs. Stewart-Warner, 303 U. S. 545;
(conflict with applicable decisions of this Court)
Carbice vs. American Patents Development, 283 U. S. 27;
Armstrong vs. Nu-Enamel Corporation, 305 U. S. 315
(importance of point of law involved).

STATEMENT.

The facts are sufficiently stated in the Petition.

STATUTES.

The statutes under which this case arises and which are necessary to be considered are Section 4886 (U. S. C., Title 35, Sec. 31) and Section 4888 (U. S. C., Title 35, Sec. 33) of the Revised Statutes of the United States.

Section 4886 of the Revised Statutes reads as follows:

"Any person who has invented or discovered any new and useful art, machine, manufacture, or composition of matter, or any new and useful improvements thereof, or who has invented or discovered and asexually reproduced any distinct and new variety of plant, other than a tuber-propagated plant, not known or used by others in this country, before his invention or discovery thereof, and not patented or described in any printed publication in this or any foreign country, before his invention or discovery thereof, or more than

one* year prior to his application, and not in public use or on sale in this country for more than one* year prior to his application, unless the same is proved to have been abandoned, may, upon payment of the fees required by law, and other due proceeding had, obtain a patent therefor."

Section 4888 of the Revised Statutes reads as follows:

"Before any inventor or discoverer shall receive a patent for his invention or discovery he shall make application therefor, in writing, to the Commissioner of Patents, and shall file in the Patent Office a written description of the same, and of the manner and process of making, constructing, compounding, and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art or science to which it appertains, or with which it is most nearly connected, to make, construct, compound, and use the same; and in case of a machine, he shall explain the principle thereof, and the best mode in which he has contemplated applying that principle, so as to distinguish it from other inventions; and **he shall particularly point out and distinctly claim the part, improvement, or combination which he claims as his invention or discovery.** The specification and claim shall be signed by the inventor. No plant patent shall be declared invalid on the ground of noncompliance with this section if the description is made as complete as is reasonably possible."

SPECIFICATION OF ERRORS.

The errors, which the petitioner will urge if the writ of certiorari is allowed, are the following:

1. The Court of Appeals for the Seventh Circuit erred in holding Baldner patent claims 2, 3, 4 and 13 not infringed by the manufacture, use and sale of the defendant-respondent's "Rock-Crusher" grease-compressors.

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* Two years for applications filed prior to August 5, 1940. Statute changed from two years to one year by Act of Congress on August 5, 1939 and effective one year later.

2. The Court of Appeals for the Seventh Circuit erred in holding that infringement of Baldner claims 2, 3, 4 and 13 is avoided by the fact that the defendant-respondent's "Rock-Crusher" grease-compressors are always sold and used with a delivery hose attached, the hose being fitted at its forward end with a coupler by which it is attachable to an automobile fitting.

3. The Court of Appeals for the Seventh Circuit erred in holding that infringement of Baldner claims 2, 3, 4 and 13 is avoided by the fact that a pressure may be built up in the grease hose (with which the "Rock-Crusher" is always sold and used) upon the meeting of external resistance by the flow of grease through the hose, coupler and fitting.

4. The Court of Appeals for the Seventh Circuit erred in holding that Baldner claims 2, 3, 4 and 13 directed to an improved grease-compressor *per se* are not infringed by defendant-respondent's equivalent grease-compressor to which is always added, in sale and use, a hose having a coupler on its end adapted to be attached to an automobile fitting.

5. The Court of Appeals for the Seventh Circuit erred in holding, in effect, that the inventor of an improved grease-compressor must include in his patent claims the old elements of a hose, a coupler and a fitting of an old and well understood aggregation in order to protect his improved grease-compressor wherein the invention resides.

6. The Court of Appeals for the Seventh Circuit erred in holding, in effect, that claims drawn to an old aggregation of a grease-compressor hose, coupler and fitting are the only type of claims which can protect an invention in a new improved grease-compressor *per se*.

7. The Court of Appeals for the Seventh Circuit erred in holding, in effect, that claims which would include an improved grease-compressor, an old hose, an old coupler and an old fitting in an old and well understood aggrega-

tion would be valid and would thus protect the improved grease-compressor when sold and used with an old hose, an old coupler and an old fitting.

8. The Court of Appeals for the Seventh Circuit erred in holding that infringement of Baldner claims 2, 3, 4 and 13 is avoided by the fact that defendant-respondent's "Rock-Crusher" grease-compressors do not have a meter or gauge of any kind added to its structure.

9. The Court of Appeals for the Seventh Circuit erred in holding that infringement of Baldner claims 2, 3, 4 and 13 is avoided by the fact that the accused "Rock-Crusher" does not include in its structure any means of counting or indicating the total number of charges of grease dispensed.

10. The Court of Appeals for the Seventh Circuit erred in holding that Baldner has no patent on anything less than his entire combination.

11. The Court of Appeals for the Seventh Circuit erred in holding that the accused "Rock-Crushers" avoid the charge of infringement because they do not include a meter, gauge or other counting or indicating mechanism in face of the fact that the claims in suit do not include, nor has it been asserted or found that they do include, any such meter, gauge or other counting or indicating mechanism.

12. The Court of Appeals for the Seventh Circuit erred in depriving the plaintiff-petitioner of the protection provided by the patent statutes as construed by this Court.

13. The Court of Appeals for the Seventh Circuit erred in holding that valid Baldner claims 2, 3, 4 and 13 directed to only a part of the entire combination disclosed in the entire specification do not protect the invention in that part from being bodily appropriated by the defendant-respondent.

14. The Court of Appeals for the Seventh Circuit erred in not reversing the decree of the District Court.

15. The Court of Appeals for the Seventh Circuit erred in not holding the Baldner patent infringed by the defendant-respondent.

16. The Court of Appeals for the Seventh Circuit erred in failing to grant the relief prayed for in the plaintiff-respondent's Bill of Complaint.

SUMMARY OF ARGUMENT.

Argument on First Conflict:

The Seventh Circuit Court of Appeals has erroneously decided in the present case that an owner of a patent can not recover for patent infringement, even though the accused grease-compressor and the patented, new improved grease-compressor are equivalent, element for element, and even though the claims in issue are unanticipated and admittedly valid, because, and for the sole reason that, the claims are confined to the vital part of the equipment; to wit, the new improved grease-compressor, and do not include an old aggregation of a grease-compressor, hose, coupler and fitting, as sold and used by the defendant-respondent. The above decision is directly contrary to the decisions of this Court in *Rogers vs. Alemite* (298 U. S. 415) and *Lincoln vs. Stewart-Warner* (303 U. S. 545).

Argument on Second Conflict:

Notwithstanding the fact that (1) the Baldner claims in suit are valid and unrestricted by the prior art, (2) the Baldner machine and the accused machine are mechanical equivalents, and (3) the claims in suit "read on" the accused machine, element for element, the Seventh Circuit Court of Appeals exonerated the accused "Rock-Crushers" upon the erroneous ground that the "entire specification" is the measure for the patented invention rather than the claims and that the patent does not protect from infringement anything other than the "entire combination" disclosed in the "entire specification." The Court of Ap-

peals disregarded the claims in suit and took the "entire specification" as the measure of the patent, contrary to the principle repeatedly enunciated by this Court in the case of *Continental Paper Bag Co. vs. Eastern Paper Bag Co.* (210 U. S. 405), the case of *Leeds and Catlin vs. Victor Talking Machine Co.* (213 U. S. 301), the case of *Altoona Theaters vs. Tri-Ergon Corp.* (294 U. S. 477) and other cases.

ARGUMENT.

The two grounds of conflict between the decision of the Seventh Circuit Court of Appeals and the fundamental principles of patent law as firmly established by the decisions of this Court are discussed here in the order followed in the foregoing Petition.

Argument On the First Conflict.

This Court has explicitly held that claims drawn to an old aggregation or exhausted combination of a grease-compressor, hose, coupler and automobile fitting, are invalid and improper as an attempt to create an unlawful monopoly beyond the actual invention. The Circuit Court of Appeals for the Seventh Circuit has nevertheless decided in the case at bar that claims drawn to an old aggregation of a grease-compressor, hose, coupler and fitting are the *only* type of claims which can protect an invention in a new grease-compressor and that claims confined solely to the new improved grease-compressor *per se* are avoided and are not infringed by an equivalent grease-compressor to which are added, as sold and used, a hose, coupler and automobile fitting.

In other words, the Seventh Circuit Court of Appeals has erroneously decided in the present case that an owner of a patent can not recover for patent infringement, even though the accused grease-compressor and the patented, new improved grease-compressor are equivalent, element for element, and even though the claims in issue are un-

anticipated and admittedly valid, because, and for the sole reason that, the claims are confined to the vital part of the equipment; to wit, the new improved grease-compressor, and do not include an old aggregation of a grease-compressor, hose, coupler and fitting, as sold and used by the defendant-respondent.

This Court, in the case of *Rogers vs. Alemite,* ruled adversely upon the validity of claims which included:

> "The claimed combination is, therefore, of four things: (1) a type of pin fitting which was old in the art; (2) a pump for creating pressure, which was old; (3) a hose to connect the two; and (4) a well known type of coupler." *Rogers vs. Alemite,* 298 U. S. 415, 419.

In the *Rogers* case the invention resided in a small, improved hose coupler while in the present case the invention resides in a large, power driven, improved grease-compressor, both the improved hose coupler and improved grease-compressor being usable in an old and well understood aggregation. The question of the proper manner to claim an improvement in a hose coupler or an improvement in a grease-compressor was discussed and decided by this Court as follows:

> "While Gullborg's invention was confined to an improvement in the hose coupler, which is but one element in the old and well understood combination of a compression chamber or pump, a hose, a hose-coupler, and a grease cup or fitting connected to the bearing to be lubricated, his claims are not for the improvement as such but all are for a *combination of the old elements* with the improved form of coupler.
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> "The question then is whether, by this method, the patentee, by improving one element of an old combination whose construction and operation is otherwise unchanged, may, in effect, repatent the old combination by reclaiming it with the improved element substituted for the old element. That this *cannot be done* is shown

by numerous cases in this and other federal courts." *Rogers vs. Alemite,* 298 U. S. 415, 419, 425.

The same question was presented a *second* time to this Court in an appeal from the Seventh Circuit Court of Appeals, wherein the present defendant-respondent was again a party, in the case of *Lincoln vs. Stewart-Warner.* In deciding the *Lincoln vs. Stewart-Warner* case, this Court reaffirmed the decision of the *Rogers* case and again condemned the practice of attempting to obtain an unwarranted monopoly by claiming the old aggregation of grease-compressor, hose, coupler and automobile fitting when in fact the invention resided in only one of those four elements. This Court again discussed, re-iterated and decided the same fundamental principle of patent law as is presented in the case at bar, in the following unmistakable language:

> "Like that in the *Rogers* case, the patent in suit has to do with apparatus for lubricating bearings, especially those of automobiles, by the use of a nipple or fitting connected with the bearing, a gun consisting of a compressor or pump for propelling the lubricant under high pressure, a hose or conduit to connect the pump with the fitting, and a means of coupling the conduit to the fitting to make a tight joint during the operation of greasing.
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> * * * * *
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> "Butler's alleged invention is in the same field and deals with similar apparatus as did Gullborg's patent, considered in the *Rogers* case. As there shown, it was old practice in the lubrication of bearings to use in combination a fitting connected with the bearing through which oil or grease was to be propelled into the bearing and a gun, which was joined to the fitting by a coupler.
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> * * * * *
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> "As we said of Gullborg in the *Rogers* case, having hit upon this improvement he did not patent it as such but attempted to claim it in combination with other old elements which performed no new function

> in his claimed combination. The patent is therefore void as claiming more than the applicant invented. The mere aggregation of a number of old parts or elements which, in the aggregation, perform or produce no new or different function or operation than that theretofore performed or produced by them, is not patentable invention. And the improvement of one part of an old combination gives no right to claim that improvement in combination with other old parts which perform no new function in the combination.
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> * * * * *
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> "We conclude that Butler's effort, by the use of a combination claim, to extend the monopoly of his invention of an improved form of chuck or coupler to old parts or elements having no new function when operated in connection with the coupler renders the claim void." *Lincoln vs. Stewart-Warner,* 303 U. S. 545, 546, 549, 552.

In the face of, and in opposition to, the established and fundamental principle of patent law so clearly and definitely stated by this Court, the Circuit Court of Appeals for the Seventh Circuit in the case at bar has decided that the accused "Rock Crusher" grease-compressors are to be exculpated and freed from infringement because:

> "They are always *sold and used* with a delivery hose attached, the *hose* being fitted at its forward end with a *coupler* by which it is attachable to the lubricant fitting." (R-II 1044.)

Thus, the Seventh Circuit Court of Appeals has penalized the patentee and deprived the owner of the patent of the protection granted by the patent laws for a new and useful invention simply because the patent claims are drawn to the improved grease-dispenser *per se* in line with the law enunciated by this Court rather than in accordance with the erroneous proposition *now twice* advanced by the Seventh Circuit Court of Appeals and for which it has already been expressly reversed by this Court in the case of *Lincoln vs. Stewart-Warner.*

Not unlike the facts in the case of *Lincoln vs. Stewart-Warner,* an endeavor has been made in this case to attribute some new function to the hose in the old aggregation. In the *Lincoln vs. Stewart-Warner* case, this present defendant-respondent vainly attempted to advance a similar contention by arguing that the hose introduced some new intangible function into the Butler coupler, producing a combination instead of an aggregation. This Court refused to be misled by such an erroneous theory and in answer thereto said:

> "The weakness of the respondent's position is well illustrated by what developed at argument. When interrogated as to how in the claimed combination the function of the nipple could be thought novel in any different sense than the function of the pump, counsel replied that the pump performed a novel function because the pressure it generated forced forward the piston in the coupler and caused the movable jaws to engage the fitting. If this argument is sound, the respondent may convict every one who sells a grease pump of contributory infringement. The answer is the same as in the case of the headed nipple. The function of a pump has always been to force a fluid or a grease through a conduit. The fact that this function of the pump is utilized in Butler's improved form of coupler not only to convey the lubricant to the bearing but to operate the jaws of the chuck does not alter the function of the pump." *Lincoln vs. Stewart-Warner,* 303 U. S. 545, 551.

However, the Seventh Circuit Court of Appeals, apparently unrestrained by this Court's prior decision, proceeded to exonerate from infringement the defendant-respondent's "Rock Crusher" because of the hose attached to the "Rock Crusher" and the pressure which may be built up in the hose by reason of external resistance offered to the flow of the discharged grease. A quotation from the decision of the Circuit Court of Appeals, bearing upon this point, is as follows:

"Continued operation of the motor will pump grease through the *hose* into the *fitting* through which the automobile bearing is lubricated. *If* the moving lubricant meets with *resistance* because of dirt, rust or dried grease in the *fitting* or bearing, the motor will compress the grease until the resistance is overcome, the machines being *capable of building up grease pressure* of more than five thousand pounds per square inch." (R-II 1044.)

As pointed out in the Petition, the Baldner grease-dispensing machine also was capable of building up grease pressure of more than five thousand pounds per square inch. On actual demonstration in court the Baldner machine produced a higher pressure than the defendant-respondent's machine, reaching **7000** pounds pressure per square inch. (R-I 224.)

That the forcing of grease through a hose is an old and well known function of a grease compressor and that a high pressure can be built up in a hose in opposition to resistance to flow, has been fully recognized by this Court, as for example:

"By the downward stroke of the plunger the entrance to the pump chamber is closed and the grease therein forced *into the hose* and through the *coupling* and pin *fitting* to the bearing. By successive strokes a very *high pressure can be built up* in the hose." *Rogers vs. Alemite,* 298 U. S. 415, 422.

This Court has likewise recognized the fact that the adding of a hose does not alter the function of the pump or grease-compressor:

"The function of a pump has *always been to force a fluid or a grease through a conduit.* The fact that this function of the pump is *utilized* in Butler's improved form of coupler not only to convey the lubricant to the bearing but to operate the jaws of the chuck *does not alter* the function of the pump." *Lincoln vs. Stewart-Warner,* 303 U. S. 545, 551.

Argument on the Second Conflict:

As pointed out in the Petition, Baldner's patent specification, besides showing, describing and claiming his power driven two-stage grease-dispensing machine also shows and describes a small meter or dial and an electrical switch controlling circuit which may be optionally superimposed upon the grease-dispensing machine, in order to indicate or register the total amount of grease dispensed or delivered by the grease-dispensing machine. In other words, the Baldner specification not only showed and described his novel two-stage grease-dispensing machine or "grease-gun" but also showed and described a tachometer to count the number of cycles or strokes of his booster pump. There has been no charge that the defendant-respondent has used the small meter, dial or gauge, or the electrical control circuit which are disclosed in the patent specification. The charge of infringement is directed to the large grease-dispensing machine, *per se*. The Baldner grease-compressor and the defendant-respondent's compressor are structurally equivalent. The parts of one machine are readily interchangeable with the corresponding parts of the other machine.

The counting dial and the electrical controlling circuit in the Baldner specification are not included in the claims 2, 3, 4 and 13 in suit. Notwithstanding this fact, however, the Circuit Court of Appeals excused the "Rock Crushers" from infringement in the following language:

> "The 'Alemite Rock Crushers' are never sold as *metering* or measuring devices, and could not be so used. * * * There is *no meter or gauge* of any kind *included* in the structure which is used or usable to measure the quantity of grease discharged, and in lubricating a car there is *no way of knowing* how many cubic inches of lubricant may be used." (R-II 1044.)
>
> "Assuming without conceding that the accused structures, *so far as they go*, use precisely the *same means* as the patent uses, yet appellee could not be

held for infringement, for Baldner has *no patent* on anything *less* than his *entire combination.*" (R-II 1046.)

This ruling that the accused "Rock Crushers" avoid the charge of infringement because they do not include a meter, gauge or other counting or indicating mechanism, was made in face of the fact that the claims in suit do not include nor attempt to include, nor has it been asserted or found that they do include, any such meter, gauge or other counting or indicating mechanism, as for example claim 3 of the patent:

> "3. In an apparatus of the character described, a reservoir, an ejector communicating therewith dividing the discharged material into successive charges of known capacity and conveyor means for supplying the material to the ejector in quantity greater than its capacity whereby said ejector will act to impede the normal flow of the material under influence of the first ejector and will be operated at full capacity to discharge the material in known measured quantity."

The "measured quantity" last referred to in the claim is in the *singular* rather than in the plural. The action of the booster or ejector described in the claim is a single cycle or stroke action ejecting one full "shot" of grease. The measured quantity discharged in this one action is an increment in an amount determined by the fixed capacity or size of the booster or ejector chamber, provided, of course, that the booster or ejector chamber has been *completely filled* with solid grease. There is *no* reference in the claim to a computation or tabulation of the *total* amount of grease, in pounds or quarts, which may be dispensed by a series of counted or determined number of cycles or strokes of the ejecting piston of the booster. Both the patented grease-dispensing machine and the accused grease-dispensing machine have their respective booster chambers *completely filled* with grease and discharge the grease in the full measured quantity fixed by the volumetric capacity or size of the booster chamber, as called for by example claim 3.

The method of operation of both the Baldner grease-compressor and the accused grease-compressor is the same, in that when the pump or ejector piston is retracted or actuated beyond the intake orifice communicating with the supply reservoir, grease is forced into the pump chamber by the screw-conveyor in the supply reservoir. The pump or ejector chambers are of a *fixed volume or known capacity.* By the discharge stroke or movement of the pump or ejector piston, the entrance to the pump or ejector chamber is closed and *all* of the grease entrapped therein is forcibly discharged into the hose. Thus, upon each successive discharge stroke or movement of the piston, the grease is divided into charges of a *fixed or known quantity,* as called for in the claim 3 and others. The screw-conveyor supplies the grease to the pump or ejector chamber in quantities greater than its capacity or fixed volume. The pump or ejector impedes the normal flow of the advanced grease and enables the screw-conveyor to pack the grease *solid* against the intake orifice of the pump or ejector chamber to expel or churn out the air contained in the air pockets of the grease. This prevents the pump or ejector from becoming "air bound." As a result, the pump or ejector chamber is always filled with *solid* grease and is operated at *full capacity* devoid of air pockets. The entrapped grease in the pump or ejector chamber being solid and the pump or ejector chamber being of a fixed or known capacity, insures that the material upon each successive discharge stroke or movement of the piston is of a *known measured quantity,* as called for in the claim 3 and others. From the above, it is clearly evident that the claim 3, for example, does not include nor attempt to include, nor has it been asserted or found that it does include, any meter, gauge or other counting or indicating mechanism.

Thus, the Baldner patent disclosure comprises two parts, one describing the two-stage grease compressor and the other describing the meter, dial or registering mechanism. The Circuit Court of Appeals disregarded the claims

in suit and took the "entire specification" as the measure of the patent. This Court has explicitly held that it is the *claims* of a patent which define an invention and that therefore the *separate claims* must be examined to determine whether there has been an infringement of the patented invention. This Court has stated:

> "The Court of Appeals, in upholding the patent, made no examination of its *separate claims,* but treated the patent throughout as though it were a combination of five distinct elements, the photoelectric cell, the arcuate flexing of the film, the flywheel, the flexible connection of the flywheel and the optical slit, although nowhere in the patent is any such combination claimed. The patent thus upheld is one which was neither claimed nor granted. Under the statute it is the *claims* of the patent which define the invention." *Altoona Theaters vs. Tri-Ergon Corporation,* 294 U. S. 477, 487.

Some claims may be directed to an entire combination and other claims of the same patent may be directed to but a part of that entire combination in order to protect the invention residing in that individual part, for claims are separable and cover independent inventions. The entire combination disclosed in the entire specification need not be appropriated to constitute infringement of claims confined to but a part of the entire combination.

> "Besides, a patent may embrace more than one invention. *Steinmetz v. Allen,* 192 U. S. 543. A process and an apparatus by which it is performed are distinct things. They may be found in one patent; they may be made the subject of different patents. So may other dependent and related inventions.
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> "A combination is a union of elements, which may be partly old and partly new, or wholly old or wholly new. But whether new or old, the combination is a means—an invention—distinct from them. They, if new, may be inventions and the proper subjects of patents, or they may be covered by claims in the same patent with the combination.

"But whether put in the same patent with the combination or made the subjects of separate patents, they *are not identical* with the combination.

* * * * *

"Claims are *independent* inventions. One may be infringed, others not, and the redress of the patentee is limited to the injury he suffers, not by the abstract rights which have been granted him in other claims. One claim may be valid, all the rest invalid; invalid for the want of some essential patentable attribute. But what is good remains and is unaffected by its illegal associates. In such cases the patent does not stand or fall as a unity. If claims may be separable as in the case of infringement of some and not of others; if claims can be separable, though some are invalid, may they not be separable when some of them have expired?" *Leeds and Catlin vs. Victor Talking Machine Co.*, 213 U. S. 301, 318, 319.

In the face of, and in direct violation of, this Court's statement of the principle of patent law that it is the claims of a patent which measure the patented invention and determine the scope of the patent monopoly, the Seventh Circuit Court of Appeals in the case at bar expressly decided that:

"Assuming without conceding that the accused structures, *so far as they go,* use precisely the *same means* as the patent uses, yet appellee could not be held for infringement, for *Baldner has no patent* on anything less than his *entire combination.*" (R-II 1046)

This Court has specifically laid down the rule that the *claims* of a patent must be examined to determine whether there has been an infringement of the patented invention because the claims are of primary importance in the determination of the invention that is patented. Nor are the claims to be twisted so as to include something different from that which their words express. This rule has been stated as follows:

> "Some persons seem to suppose that a claim in a patent is like a nose of wax which may be turned and twisted in any direction, by merely referring to the specification, so as to make it include something more than, or something different from, what its words express." *White vs. Dunbar,* 119 U. S. 47, 51.

An inventor is not confined to the detailed description set forth in the entire patent specification as this detailed description merely sets forth a preferred or suggested mode of applying the invention. This well established principle was expressly recognized by this Court in the following language:

> "We think it is clear that the court considered that Liddell sought to comply with Section 4888 of the Revised Statutes. In other words, he filed a description of his invention, explained its principle and the best mode in which he 'contemplated applying that principle,' and did not intend to give up all other modes of application. An inventor must describe what he conceives to be the best mode, but he is not confined to that. *If this were not so most patents would be of little worth." Continental Paper Bag Co. v. Eastern Paper Bag Co.,* 210 U. S. 405, 418.

CONCLUSION.

In conclusion, it is submitted that the decision and judgment of the Court of Appeals for the Seventh Circuit should be reviewed and reversed by this Court as being in direct conflict with the applicable decisions of this Court and as being completely contrary to the vitally important principles of patent law established by the decisions of this Court, and that therefore the writ of certiorari should be granted.

Respectfully submitted,

KENNETH S. CLAPP,

By BRUCE B. KROST,

Counsel for Petitioner.

APPENDIX.

In the
UNITED STATES CIRCUIT COURT OF APPEALS
FOR THE SEVENTH CIRCUIT.

No. 7089. OCTOBER TERM AND SESSION, 1940.

KENNETH S. CLAPP,
Plaintiff-Appellant,
vs.
STEWART-WARNER CORPORATION,
Defendant-Appellee.

Appeal from the District Court of the United States for the Northern District of Illinois, Eastern Division.

December 5, 1940.

Before SPARKS, MAJOR and KERNER, *Circuit Judges.*

SPARKS, *Circuit Judge.* Appellant charged appellee with infringement of United States patent No. 1,570,032 to Baldner, issued January 19, 1926, on an application filed June 7, 1921. This bill also charged appellee with infringement, and the inequitable appropriation, of United States improvement patent No. 1,980,117 to Clapp and Eickhoff. Both of these patents were owned by appellant at all times here in question. The defenses were invalidity and non-infringement. Claims 2, 3, 4 and 13 of the Baldner patent, and claims 1, 8, 13, 22 and 27 of the Clapp patent were relied upon. At the trial, however, appellant withdrew his charges of infringement as to claims 8, 13, 22 and 27 of the Clapp patent.

Special findings of fact were filed by the court, upon which it concluded that appellee had not infringed claim 1 of the Clapp patent, or any of the claims at issue of the Baldner patent. The decree was in accordance with the conclusions of law, dismissing the complaint as to both patents for want of equity. The appeal is from that part of the decree which affects only the Baldner patent.

This patent, which is a continuation in part of the patentee's then pending application, serial No. 453,978, filed March 21, 1921, relates to dispensing apparatus for plastic or semi-fluid materials, and more particularly to measuring means therefor, by which the discharge is regulated in measured quantity. Its primary object is to simplify

the structure and the means and mode of operation of such apparatus, whereby it will be cheaper in construction, more efficient in use, positive in operation, uniform in action and accurate. Other objects are to provide a dispensing apparatus with a control device which will insure the uniform and continuous discharge of the material in measured quantities; to provide automatic control means by which the discharge mechanism will be automatically arrested when a predetermined quantity of the material has been ejected; to provide means for readily adjusting the apparatus to discharge the material in greater or less measured quantity; to further provide for automatic coin or finger control for setting the mechanism in operation; and to provide in conjunction with the dispensing apparatus a booster, or ejector pump, to insure uniform and continuous discharge.

The patented apparatus comprises a container for the material which is discharged in measured quantity. The container rests upon a base which contains the dispensing, or ejecting apparatus, and the base is provided with an inlet opening with which the open bottom of the container registers. The bottom of this base, or housing, comprises a plurality of parallel, semi-circular grooves which communicate with concentric bores, or circular passages in the housing, and extend beyond the receiving opening. Located in each of the semi-circular grooves, and extending into the corresponding bore, is a revoluble spiral conveyor, of which there may be any number in the series. These conveyors extend a sufficient distance through the bores to afford ample bearing therein for the conveyor screws, while at the opposite end, the conveyor screws are provided with trunnions or drive shafts, having bearings in the terminal wall of the receiving recess, through which they extend into the adjacent pocket, or chamber, where they carry intermeshing gear pinions.

The drive shaft of one of the conveyor screws is extended beyond the housing of the base to afford a drive connection for the series of conveyor screws. The conveyor screws may be manually operated by means of a hand crank, or they may be motor driven. The shaft extension is, or may be, provided with a beveled gear pinion with which meshes a second pinion upon a vertically disposed drive shaft. Carried by the shaft is a worm wheel, with which meshes a worm upon the armature shaft of a driving motor. Upon operation of the driving motor, the spiral conveyors will be simultaneously actuated to dis-

charge grease or other plastic or semi-fluid material from the container, through the lateral boxes into the pressure chamber formed at one end of the base or housing. The bores all communicate with this pressure chamber and simultaneously discharge thereinto.

At its upper end the vertically disposed drive shaft carries a bevel gear, meshing with a similar gear upon a transverse shaft to which may be connected a hand crank for hand operation of the apparatus. Whether by hand crank or motor, the worm wheel will be connected to the shaft by a pawl and ratchet. Thus far described, the mechanism is substantially that disclosed and claimed in Baldner's co-pending application.

Leading from the pressure chamber of the base is a discharge conduit, in which is a rotary power-driven meter, comprising a cylindrical housing having inlet and outlet passages. Mounted eccentrically within the circular housing is a rotor having therein two oppositely disposed overlapping sliding blades or vanes. These are bifurcated on their inner edges to receive a spring by which the blades are forced apart and against the wall of the housing as the rotor revolves. During the rotation of the rotor the blades reciprocate to and fro, maintaining at all times their bearing contact upon the interior walls of the cylinder under the influence of the spring.

The grease or other plastic or semi-fluid material enters the cylinder from the pressure chamber through the inlet passage, filling the space immediately back of the blade until the succeeding blade passes the inlet part, whereupon the charge of material is forcibly advanced by the movement of the blade.

The capacity of the spiral conveyors is greater than that of the rotary meter so that the material is always maintained in the pressure chamber and supplied thence to the rotary meter under a relatively high pressure. The excess material advanced by the spiral conveyor merely leaks back, or when the bores are filled to the maximum pressure, no more material can be forced therein and the material will merely push backwardly into the container, thus insuring at all times an ample supply of material under pressure at the inlet part of the rotary meter, which in turn insures the intake chamber of the meter being fully and completely filled at a uniform pressure at each rotation of the rotor. This intake chamber being of a predetermined capacity receives a like charge at each half rotation of the rotor,

and serves as a unit of measurement. The rotary meter is so designed that a predetermined number of rotations shall equal exactly one pound, or a pint, or a quart of the material as desired by the purchaser.

Upon rotation of the blades, the charge of material received upon the cylinder is discharged upwardly through the outlet and the discharge conduit. The rotor is positively driven by means of a bevel gear upon the shaft of the rotor, meshing with a similar gear upon a vertically disposed shaft, mounted in a suitable bearing in the top wall of the pressure chamber. At its lower end the vertical shaft carries a gear pinion meshing with a similar pinion upon a stub shaft carried by one of the spiral conveyors, thus driving the rotary meter and the spiral conveyors in unison.

The specifications continue in a lengthy description of Baldner's meter, or measuring device, and its operations. That part of the description is considerably longer than that which we have heretofore set out. It specifically describes the means by which the predetermined amount of the material desired by the purchaser may be delivered to him immediately by either manually operating a switch to start the motor or by a coin-controlled means by which the switch is closed upon the insertion of a coin of proper size.

It is suggested by appellant that it is not necessary for us to consider this part of Baldner's disclosure, because it is not contended that appellee has infringed this particular feature. This, indeed, is quite true, and while it is not necessary to set forth this particular specification, yet it is quite proper for us to consider the entire specification in order to determine the real content of Baldner's claims.

The claims in issue[1] disclose a combination whose elements are conceded to be old in the art. It is a lubricant-

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[1] "2. In an apparatus of the character described, the combination with a supply reservoir of two separate ejector mechanisms communicating therewith and interconnected in series whereby one ejector supplies the other, the initial ejector being of greater capacity than the second ejector, the second ejector acting to impede the normal output of the first ejector, and discharging the material, at lower pressure, and means to operate said ejectors in unison, the quantity of discharge being measured at the full capacity of the second ejector.

"3. In an apparatus of the character described, a reservoir, an ejector communicating therewith dividing the discharged material into successive charges of known capacity and conveyor means for supplying the material to the ejector in quantity greater than its capacity whereby said ejector will act to impede the normal flow of the material under influence

vending machine, pure and simple. Of course, the amount of lubricant sold is governed by the demand of the customer and is subject to as many variations as there are customers. The accused devices are two types of machines known as "Alemite Rock Crushers," both of which are motor-driven lubricant compressors adapted to deliver grease through a hose conduit to automobile lubricant fittings, where grease is delivered to bearings under pressure of five thousand pounds and higher, per square inch. They are also called grease guns. One type is driven by compressed air and the other by electricity. Each type comprises a funnel-shaped reservoir to contain a supply of lubricant, at the lower part of which is a helical screw conveyor positioned vertically in the hopper. This conveyor is rotated by a ratchet which advances one notch with each stroke of the compression pump. The step by step rotation of the helical screw slowly advances grease from the reservoir towards the reciprocating pump, located at the bottom of the reservoir and below the screw conveyor. When the plunger of the reciprocating pump is in a retracted position, the advancing grease advanced from the reservoir is forced into the cylinder of the reciprocating pump and, under the influence of the power means, the plunger or piston of the reciprocating pump is alternately driven into the cylinder and retracted therefrom. On its forward movement, the piston drives the grease in the cylinder through an outlet valve (through which the grease cannot return), into a hose which is equipped at its forward end with a coupling member for attachment to the fittings of the bearing to be lubricated. Continued operation of the motor will pump grease through the hose into the fitting through which the automobile bearing is lubricated. If the moving lubricant meets with resistance because of dirt, rust, or

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of the first ejector and will be operated at full capacity to discharge the material in known measured quantity.

"4. In an apparatus of the character described, a reservoir, an auxiliary pressure chamber communicating therewith, means for discharging the contents of the reservoir, into said chamber under pressure, a discharge conduit and an intermediate measuring chamber of known capacity communicating alternately with the pressure chamber, and with the discharge conduit for discharging the material from said pressure chamber in measured quantity."

"13. In an apparatus for dispensing plastic material in measured quantity, the combination with a reservoir and an ejector means therefor, advancing the material under pressure, of a discharge conduit and a flow regulating device controlling the discharge outlet normally resisting the advance of material under influence of the ejector and permitting the escape thereof in measured quantity, and means for actuating the regulator in accordance with the quantity of material advanced by the ejector means."

dried grease in the fitting or bearing, the motor will compress the grease until the resistance is overcome, the machines being capable of building up grease pressure of more than five thousand pounds per square inch.

These "Alemite Rock Crushers" are never sold as metering or measuring devices, and could not be so used. They are always sold and used with a delivery hose attached, the hose being fitted at its forward end with a coupler by which it is attachable to the lubricant fitting. There is no meter or gauge of any kind included in the structure which is used or usable to measure the quantity of grease discharged, and in lubricating a car there is no way of knowing how many cubic inches of lubricant may be used. In these devices the worm or screw in the reservoir advances the grease slowly and under very low pressure of not more than three pounds per square inch into the cylinder of the high pressure lubricating delivery pump, the vacuum created in the cylinder by retraction of the piston being largely responsible for filling the cylinder with grease.

It is clear that the patented device is not infringed by the accused structures. They do not perform the same functions, and the means and results are entirely different. It was pointed out by the District Court that in the patented article the greater pressure was in the upper chamber, and the lesser pressure was in the lower chamber, while in the accused structures it is just the reverse. Great pressure is not necessary in the operation of the patent, for the inventor was only concerned in delivering the measured amount into any receptacle of the purchaser's choosing. A different problem, however, confronted appellee, for its object was to deliver the grease to the different bearings in the automobile through a hose, and this admittedly requires a great deal of force. Appellee was not concerned with the exact amount that it was delivering for the benefit of the purchaser. Its object was to deliver whatever was necessary for greasing the bearings, and no one could tell how much that would be. Under these circumstances a meter was not necessary to accomplish appellee's objects, and the accused devices have no such means.

It is contended by appellant, however, that appellee uses the equivalent of a meter. He argues that when the lower chamber is filled to its capacity with grease from the upper chamber, that constitutes a measured amount in the lower chamber; and as this amount is thus separated from the

upper chamber, it is in that sense a measured amount and reads upon the claims of the patent. We cannot accept this interpretation. There is no measuring of the amount used by the accused structures. True, the amount used in the lower chambers of the accused devices is limited by the capacity of the lower chamber, but this cannot be considered as a measurement in the sense that Baldner used it, for his measurement in no way depended upon the capacity of the lower chamber but rather upon the demand of the customer. His measurement had to be accurate, and it was quite necessary for him to have an accurate meter in order to compensate for the price he was to receive for it. When these claims are read and interpreted in the light of Baldner's specification and description, it is obvious that they do not read upon the accused structures.

Having thus limited the patent to a metering or measuring device, operating as Baldner described it, we find it unnecessary to pass upon the question of validity. Because of the lack of infringement, the District Court dismissed the complaint for want of equity. Assuming without conceding that the accused structures, so far as they go, use precisely the same means as the patent uses, yet appellee could not be held for infringement, for Baldner has no patent on anything less than his entire combination.

Other questions are raised which bear on the question of validity. However, appellee admits no concern in the question of validity, in view of our interpretation of the patent. While the District Court held the patent was invalid, even if there was infringement, yet, it cited no specific prior art upon which that judgment was based. Under these circumstances we deem it unnecessary to express any opinion on the question of validity, and leave appellant with the benefit of the presumption which the issuance of the patent bestows upon it.

DECREE AFFIRMED.

A true Copy:

Teste:

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Clerk of the United States Circuit Court of Appeals for the Seventh Circuit.

(2)

Office - Supreme Court, U. S.
FILED
MAR 26 1941
CHARLES ELMORE CROPLEY
CLERK

IN THE

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1940.

No. 808.

KENNETH S. CLAPP,
Plaintiff-Petitioner,
vs.
STEWART-WARNER CORPORATION,
Defendant-Respondent.

RESPONDENT'S BRIEF.

LYNN A. WILLIAMS,
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Counsel for the Defendant-Respondent.

Eastman Bros., Law Printers, 542 S. Dearborn St., Chicago

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RESPONDENT'S BRIEF.

Mr. Clapp brought a patent infringement suit against Stewart-Warner under Baldner patent 1,570,032.

At the end of a two weeks' trial, the District Court rendered an oral opinion and entered findings holding that the Baldner patent had not been infringed and that it would be invalid if interpreted in such a way as to describe the Stewart-Warner Company's grease gun, and a decree was entered dismissing the complaint for want of equity.

The Court of Appeals affirmed the decree of the District Court, and in so doing wrote an opinion holding that there was no infringement and that it was

unnecessary, therefore, to determine whether or not the patent was valid.

Mr. Clapp does not like the concurring decisions of the District Court and the Court of Appeals.

Apparently his counselors believe that it is expedient, in an effort to bring about a contrary adjudication, completely to misrepresent to this Court the facts and the grounds of the decisions in the lower courts.

The all sufficient essence of the ultimate fact is, in reality, that what the defendant, Stewart-Warner Corporation, sells is a system for lubricating the chassis bearings of an automobile. One of the parts of such a system is a high pressure "grease gun." This grease gun must from time to time be refilled with grease.

What the patentee Baldner did related to "dispensing apparatus for plastic and semi-fluid materials, and more particularly to measuring means therefor by which the discharge is regulated in measured quantity" (Baldner patent, p. 1, lines 9-13, R. p. 683). Such a device might be used in refilling a grease gun with grease and automatically measuring in quarts or pounds the quantity of grease thus supplied to the grease gun.

Throughout the trial and appeal of this case, the effort of Mr. Clapp and his counselors has been to contort the plastic measuring and dispensing device of the Baldner patent into a high pressure grease gun of an automobile lubricating system, and then to assert that the defendant's grease gun infringes the Baldner patent because it is essentially identical with Baldner's "grease gun,"—as plaintiff's counselors find it expedient to rename the measuring dispensing apparatus of the Baldner patent. The Stewart-

Warner Company sells its highpressure grease guns under the fanciful trade name of "Alemite Rock Crushers." As was said by the Court of Appeals in its opinion:

> "These 'Alemite Rock Crushers' are never sold as metering or measuring devices and could not be so used. . . . There is no meter or gauge of any kind included in the structure which is used or usable to measure the quantity of grease discharged, and in lubricating a car there is no way of knowing how many cubic inches of lubricant may be used." (R. II, p. 1044.)

As was said in the opinion of the Court of Appeals relative to the subject matter of the claims in issue of the Baldner patent "The claims in issue disclose a combination whose elements are conceded to be old in the art. It is a lubricant vending machine pure and simple." (R. II, p. 1043.)

It was for this reason,—amplified and explained in some detail, that the Circuit Court of Appeals said in its opinion:

> "It is clear that the patented device is not infringed by the accused structures. They do not perform the same functions, and the means and results are entirely different." (R. II, p. 1045.)

Accordingly, the Court of Appeals affirmed the decree of the District Court, dismissing the complaint for want of equity (R. II, p. 1046).

As to the defense that the Baldner patent was, in any event, invalid, the Court of Appeals said:

> "... we find it unnecessary to pass upon the question of validity. . . . appellee" (the defendant, Stewart-Warner) "admits no concern in the question of validity, in view of our interpretation of the patent. While the District Court held the patent was invalid, even if there was infringe-

ment, yet it cited no specific prior art upon which that judgment was based. Under these circumstances we deem it unnecessary to express any opinion on the question of validity." (R. II, pp. 1045, 1046.)

In its essence, therefore, we have a patent infringement suit in which the District Court held that the Baldner patent was not infringed and that it was, in any event, invalid, and in which the Court of Appeals held that the patent was not infringed and that it was unnecessary therefore to pass upon the question of validity.

The Contortions With Which the Petitioner's Counsel Attempt to Gain Your Honors' Interest and Attention by Asserting that the Seventh Circuit Court of Appeals and the Stewart-Warner Corporation Have Long Flouted the Decisions of this Court,—and Contumaciously Continue So to Do.

It would require a brief of many pages to examine and debunk the clever subtleties of language and juxtaposition with which the plaintiff-petitioner has sought to attract your Honors' attention to this alleged disrespect for the decisions of this Court. We shall wish later to allude to some of them. For the moment, however, we should like to outline the rather simple facts of the case.

The Baldner patent in suit was applied for on June 7, 1921.

Long prior to that time the Stewart-Warner Company, or its predecessors, had been engaged in the manufacture and sale of an automobile chassis lubricating system of a kind which soon became, and still continues to be, the standard factory equipment of every automobile made in America. The earliest form

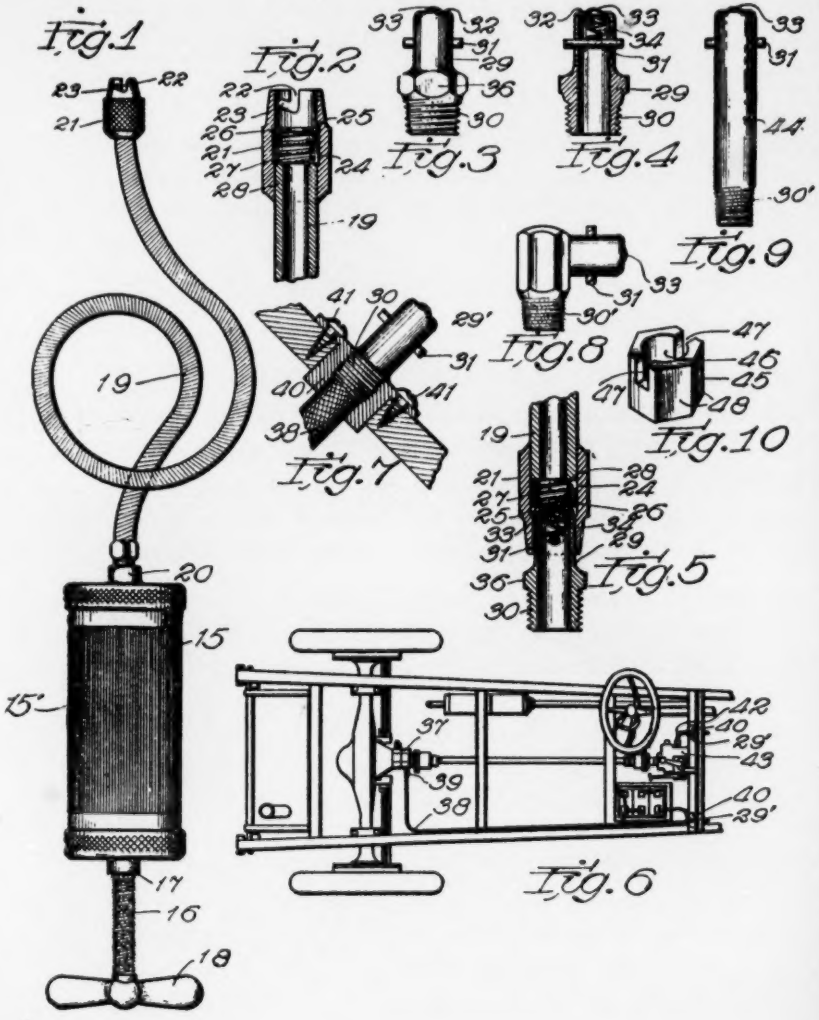
A. V. GULLBORG.

LUBRICATING MEANS.

APPLICATION FILED DEC. 21, 1918

1,307,734.

Patented June 24, 1919



Witnesses:
Andrew Winterrowd
Earl A. Price

Inventor
Arthur V. Gullborg
By Williams, Bradbury & Lee
Attys.

of this so-called "Alemite" lubricating system is shown in the Stewart-Warner Company's Gullborg patent 1,307,734 (R. p. 827). In this Gullborg patent, applied for December 21, 1918, Mr. Gullborg said:

> "My invention relates to lubricating means, and is especially concerned with means for supplying suitable lubricants to parts of machines or apparatus requiring lubrication where these parts are difficult to gain access to, and is further concerned with the provision of apparatus for supplying lubricants under pressure to movable parts, the said means comprising a grease pump or gun provided with means for detachably connecting it with the various parts to be lubricated.
>
> "The objects of my invention are:
>
> "1st. To provide novel means for supplying a lubricant under pressure to the parts of an apparatus to be lubricated, the said means comprising a grease pump or gun and means for detachably connecting the discharge (end) of said grease pump or gun with the part to be lubricated.
>
> "2nd. To provide novel coupling means for connecting the grease gun with the parts to be lubricated, the said coupling means being so constructed that when the coupling means are uncoupled or disconnected from each other there will be no excess lubricant on the outer ends of the coupling members.
>
> "3d. To provide novel means for effectively sealing the joint between the coupling members so that the lubricant may be forced between the parts to be lubricated under a very heavy pressure." (R. p. 827.)

These brief quotations sufficiently indicate that the "Alemite" lubricating system of the Gullborg patent involved many "lubricant fittings," one of which was permanently screwed into a hole leading to each of the many bearings to be lubricated, and one single grease pump or grease gun supplied with a flexible steel hose

terminating in a coupler which could be quickly attached to and detached from each of the several pin fittings. The grease gun was filled with grease and could be actuated in such a way as to force grease from the grease gun through the steel armored hose and the coupler and the fitting to which it might be attached, and thus on into the interstices of the bearing to be lubricated.

The pressures which could be applied by the grease gun to force grease through the fittings into the bearings, were so much greater than the grease pressures which could be obtained by screwing down the old-fashioned "grease cups," that the grease gun and fitting combinations were effective and successful in forcing grease into bearings which were "frozen" or clogged by dried grease, dirt, or rust (R. pp. 826, 876).

It was tiresome to use one of the hand operated grease guns of the original Gullborg patent all day long, and these hand operated grease guns were too slow in action to enable service stations to lubricate an automobile efficiently and profitably for a small price. The Stewart-Warner Corporation and its predecessors, therefore, developed and made available power driven grease guns which enabled service stations to lubricate automobiles rapidly and economically (R. pp. 451-461, 525, and 553-557). These power driven grease guns, like the hand operated grease guns of the Gullborg patent, had a small steel armored hose terminating in a coupler which could be attached to and detached from the fittings permanently applied to the bearings of all automobiles. Today practically all automobile lubrication takes place at service stations where grease is supplied by high pressure motor driven grease guns to the fittings which, at the automobile factory, are applied to every chassis bearing. The

E. W. DAVIS

LUBRICANT COMPRESSOR

Filed May 6, 1921 2 Sheets-Sheet 2

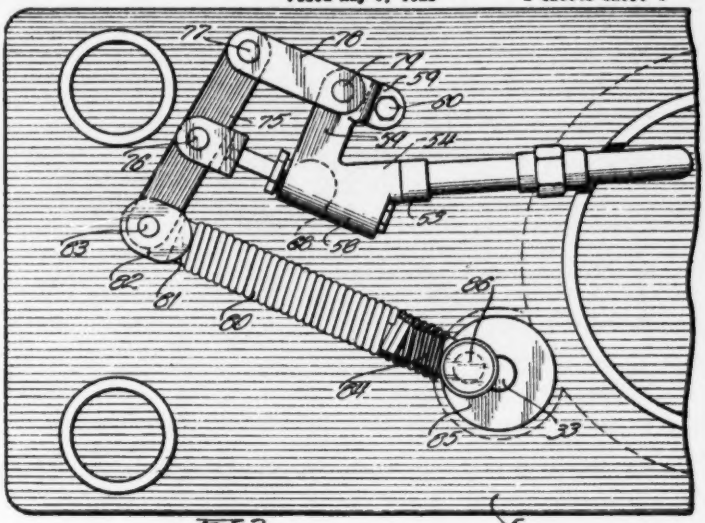


Fig. 3

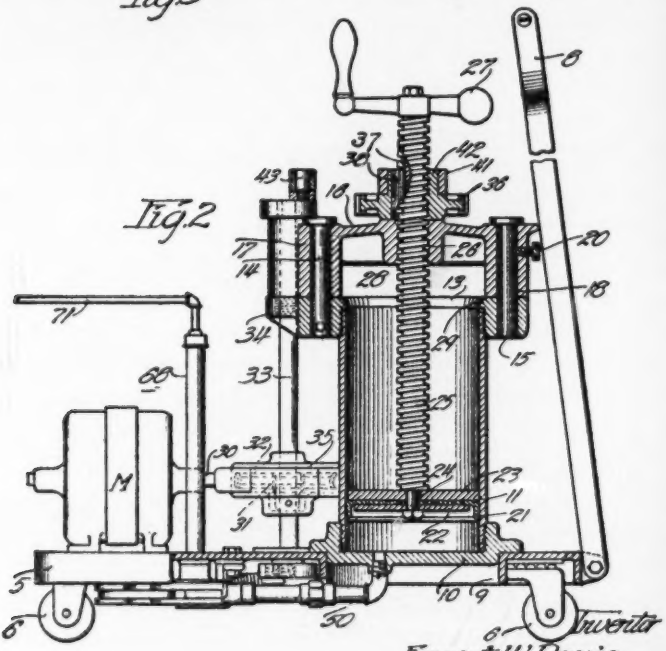


Fig. 2

Inventor

Ernest W. Davis

Williamson, Bradbury, See, & McCall Attys

result is that automobiles are now greased in a very short time and for a very reasonable price and with no inconvenience or trouble to the car owner.

These power driven grease guns which came to be used all day long in public service stations contained reservoirs holding much more grease than could be put into one of the small hand operated grease guns of the original Gullborg patent.

The record contains various examples of these power driven grease guns of the art prior to the advent of Mr. Baldner on June 7, 1921. One will suffice, namely, that shown in the patent applied for by E. W. Davis, the Stewart-Warner Corporations' chief engineer, on May 6, 1921 (R. pp. 892-8). This patent discloses one of the many similar arrangements in which a high pressure grease pump or gun 58 having a piston of small diameter was supplied with grease from a large drum or cylinder 11 equipped with a correspondingly large plunger or "follower plate 23" (page 1, line 22). A single electric motor M actuated the small piston of the high pressure cylinder and also the follower plate 23 of the grease reservoir. The result was a two-stage grease gun in which the grease was supplied from the reservoir under low pressure to the intake side of the small high pressure cylinder 58 from which it was in turn forced through the small "flexible hose 71," "the free end of this hose" being connected "with a coupling, not shown" (page 3, lines 9-12, Davis Patent Specification, R. p. 897).

In describing his grease gun, Mr. Davis said in his specification:

> "My invention is particularly adapted to form a part of a lubricating system comprising a plurality of nipples adapted to be secured to the

bearings to be lubricated and a compressor having a discharge conduit provided with a coupling which can be successively attached to and detached from the nipples for the purpose of supplying lubricant thereto under pressure.

"The objects of my invention are:—

"First; to provide a compressor capable of holding a comparatively large supply of lubricant and means for placing the lubricant under pressure sufficient to force the lubricant to the point or points desired.

"Second; to provide a compressor of the character described so constructed that it can be quickly and easily filled with lubricant. . . .

. . . . . .

"Eighth; to provide a lubricant compressor comprising a high pressure cylinder and a low pressure cylinder, the low pressure cylinder of which supplies lubricant to the high pressure cylinder, and finally

"Ninth; to provide a lubricant compressor of the character described in which both cylinders are provided with plungers driven from a single motor, the driving connections between motor and the plungers being of such character that the motor can continue to run after the lubricant in the two cylinders has reached a certain predetermined pressure without increasing the pressure upon the lubricant, and without injury to the motor."

In or about 1927 or 1928, according to the plaintiff, Mr. Clapp, the Texas Company, a large refiner of motor oils and lubricants, developed and put upon the market a new and different kind of "cup grease" which it called "Marfak" (R. p. 28). "Marfak" was a very heavy, sticky, tenacious and stringy grease of very low viscosity, bearing a much greater resemblance, in appearance and physical characteristics, to damp soap or clay than it did to the more commonly known lubricating greases of that date. The advan-

tage of this "Marfak" was that after it had once been forced into the interstices of an automobile chassis bearing, it would stay there,—it would not ooze out nor readily be forced out by the pressure between the surfaces of the bearing.

There was, however, a considerable difficulty connected with the use of this "Marfak" in the two-stage follower plate grease guns then on the market. The difficulty was due mainly to the fact that when chunks of "Marfak" were shoveled out of a barrel and dropped into the reservoir of a follower plate grease gun, large air spaces would be left between the chunks of "Marfak." It was not free flowing like water or even vaseline and would not settle down to the bottom of the reservoir in such a way as to eliminate air pockets. When, therefore, in the operation of one of these two-stage follower plate grease guns, the little high pressure pump came to a pocket of air, it would simply expand and contract so much air without effecting any intake or discharge of "Marfak."

The matter was explained in and by the testimony of Mr. Clapp, the plaintiff. He said:

> "The devices of which I had personal knowledge and which were on the market in 1927 and 1928, used the follower plate principle and none of them would feed the heavy fibrous or Marfak type of greases into the booster mechanism, and if they could not feed it into the booster mechanism free of air, they were worthless from this standpoint. The trouble in using the follower plate principle in these devices when heavy fibrous greases were attempted to be dispensed with it, was that the follower type of grease guns would not feed the lubricant through the opening into the booster and thereby created air pockets in the grease which would make the unit become in-

operative in that it would cease to pump the grease. The air pockets caused this to come about in that the air would get into the booster or cylinder mechanism and on the forward stroke of the piston air would be compressed and it would not exert enough pressure in the piston to force the grease out of the hose, which required 500 to 1000 pounds of pressure through the small air pressure grease hose. The only way the unit could become operable would be to bleed the booster pump continually, but it would not feed with this heavy material. Other disadvantages or difficulties were that the follower type of grease gun would not stir the heavy fibrous grease and get the air pockets out of it so the air pockets would be forced into the piston. The follower type of grease guns could not be used at all for the fibrous greases, because they would not feed to the booster gun at all the type of lubricant I just exhibited." (R. pp. 29-30.)

At the time Mr. Clapp gave this testimony he was mainly interested in maintaining a charge of infringement under another patent upon which this suit was originally instituted. That other patent was No. 1,980,177 issued on May 9, 1933, upon an application filed by Mr. Clapp and an associate, Mr. Eickhoff (R. I, pp. 3, 4, 174-180).

The Clapp and Eickhoff patent resulted from their joint effort to develop a grease gun which could handle the then rather new "Marfak" satisfactorily (R. p. 34). The grease reservoir of the Clapp and Eickhoff patent was provided with a helical screw conveyor which, by its rotation, worked the air pockets out of the spaces between the chunks of "Marfak" and thus pressed a solid body of "Marfak" up to the entrance of the high pressure pump (R. I, pp. 34, 220). Clapp and Eickhoff contemplated that their grease

gun should be used in delivering "Marfak" through a small steel clad hose to an "Alemite" coupler which could be attached to the fittings or nipples with which the chassis bearings of automobiles were equipped. Accordingly, Mr. Clapp decided that he ought to obtain a license from the Stewart-Warner Corporation under patents owned by it and relating to the "Alemite" coupling apparatus which Mr. Clapp wished to use with his grease gun (R. p. 35). Clapp called on officers and representatives of the Stewart-Warner Corporation to inquire about such a license (R. p. 657). Stewart-Warner made an investigation which led to the conclusion that the Clapp and Eickhoff grease gun had not been fully developed, that it would be very expensive to manufacture, and that it had a number of disadvantages which had yet to be overcome before it could be commercially manufactured and used (R. p. 658). The result was that Stewart-Warner decided not to grant a license to Mr. Clapp.

It appears from the record that Mr. Clapp learned of the Baldner patent as a result of the prosecution of his own application for a patent on the Clapp and Eickhoff device, and believing that it might be of some value to him to acquire the Baldner patent, Mr. Clapp went to Xenia, Ohio, called upon Mr. Baldner, and bought the Baldner patent in suit for about $500.00 (R. pp. 37-38).

At the trial of this cause, and according to plaintiff's witnesses, Clapp and Eickhoff were the pioneer inventors who had made possible the use of "Marfak" grease in service station lubricant compressors. According to plaintiff's witnesses, Stewart-Warner Corporation had obtained its first knowledge of how to eliminate air pockets by the use of a helical screw con-

veyor as a result of disclosures made to it by Mr. Clapp at the time he sought a license under the "Alemite" patents and at the time he disclosed the Clapp and Eickhoff machine. At the time of the trial, Mr. Clapp and Mr. Eickhoff were put forward as the men who first recognized the problem and who first solved it. Jacob Baldner was not put forward by the plaintiff as the party who had either recognized the problem of handling heavy greases or as the party who had solved the problem with his device. The Baldner patent was an appendage to the main cause of action based upon the Clapp and Eickhoff patent and upon the contention that Stewart-Warner had wrongfully appropriated a confidential disclosure of it. (Incidentally, the District Court found and held that Stewart-Warner had not infringed the Clapp and Eickhoff patent and had not appropriated any confidential disclosure, if indeed there had ever been one (R. II, pp. 661, 663),—and Mr. Clapp accepted this decision without even having taken an appeal (R. II, pp. 669, 670).

The long trial which had to do mainly with the Clapp and Eickhoff claims, developed the fact that the defendant's, Stewart-Warner's, chief engineer, E. W. Davis, had long been familiar with the use of helical screw conveyors to work air pockets out of plastic substances and to feed them forward in a solid stream. And it developed the fact that long prior to any activity on the part of Mr. Clapp and Mr. Eickhoff he had devised and made many drawings of grease guns adapted to handle heavy viscous greases, such as "Marfak," and in which he had employed a helical screw conveyor to work the air out of the grease and to feed it forward to the inlet opening of the cylinder of a high pressure grease gun (R. I, pp. 355-372).

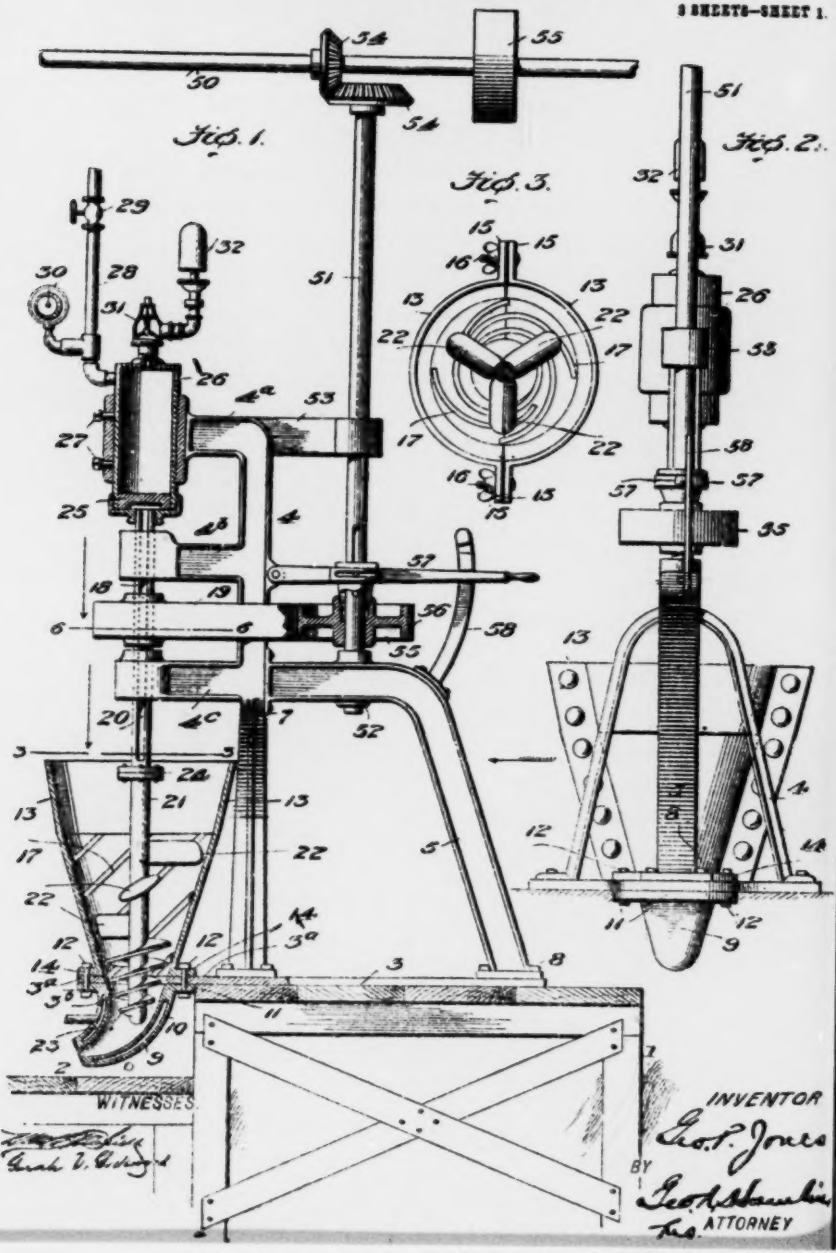
No. 869,307. PATENTED OCT. 29. 1907.

G. P. JONES.

MACHINE FOR FORMING A CARTRIDGE FROM EXPLOSIVE GELATIN.

APPLICATION FILED FEB. 9, 1907.

3 SHEETS—SHEET 1.



Some of Mr. Davis' idea sketches of grease guns employing such helical screw conveyors appear in the record at pages 531, 533, 535, 537, 539, 541, 543, etc.

The reason why the advent of the Texas Company's "Marfak" led Mr. Davis immediately to think of using a helical screw conveyor rather than a follower plate to press the grease forward toward the inlet opening of the high pressure cylinder of his grease guns, was made clear by reference to Mr. Davis' long previous experience with the use of such helical screw conveyors in connection with other plastic materials which must be moved forward in a solid stream free of air pockets. This experience had to do with machines used in forming sticks or cartridges of dynamite from explosive gelatine and of the general character illustrated in the Jones patent of 1907 (R. pp. 780-788). The general subject is sufficiently indicated by the Jones patent which covers:

> "certain new and useful improvements in machines for forming a cartridge from explosive gelatine, of which the following is a specification.
>
> "This invention relates to machines for forming a continuous cartridge from explosive gelatine.
>
> "The manufacture of cartridges from explosive gelatine which is a plastic substance of a consistency depending upon various conditions, is generally carried on by forcing it, under pressure, through a nozzle from which the gelatine emerges as a continuous rope, the diameter of which may be from less than an inch to nearly two inches, this rope being cut into suitable lengths, usually about eight inches, after emergence from the nozzle, to thereby form the cartridges which are then suitably wrapped so as to be ready for commercial use. Machines of the character set forth have usually employed a horizontal screw, termed by skilled workers in ex-

plosives, a 'packing screw' for forcing the explosive gelatine through the nozzle, and associated with this packing screw means have been employed to feed the plastic gelatine to the screw."

Mr. Davis' own personal experience with helical screw conveyors for advancing a solid stream of such plastic substances is illustrated by "an assembly drawing and a detail drawing of some of the parts of a device for feeding gelatine dynamite into cartridges" (R. p. 367). These drawings are reproduced at pages 546 and 548 of the record. (A photograph of the dynamite machine appears at page 551.) Mr. Davis testified as follows:

"Q. Before you go on with the drawing, just explain briefly what the problem was and what the need was in that connection.

"A. Gelatine is a plastic substance similar to No. 3 Marfak in consistency and it is desirable to feed the dynamite into paper cartridges in such a manner that no air will be included.

"Q. Why is that important?

"A. The purpose of extruding the air is to prevent the cushioning action of the air in the dynamite which might rob it of some of its force, and also to give the proper measured weight of the explosive in each cartridge.

"Q. Did you make the originals of these drawings?

"A. Yes, sir. I made these drawings myself.

"Q. When and under what circumstances did you do that?

"A. I made these for the General Explosives Company November 14, 1921" (R. p. 367.)

These dynamite packing machines of Mr. Davis' design were manufactured and sold by the J. W. Starrett Company (R. p. 369). In describing these machines briefly, Mr. Davis said:

"This device comprises a hopper into which the gelatine dynamite is fed, and contained within the hopper is a segmental feed screw which forces the gelatine dynamite to the bottom of the hopper. This feed screw is attached to a shaft which is driven through gearing by means of a pulley which may be connected to a source of power.

"Q. Is there any booster or means for raising the pressure?

"A. Yes, sir. Connected with the same source of power is a shaft which runs through the bottom of the hopper and which carries a worm or screw conveyor which forces the gelatine dynamite out through two nipples at the front end of the machine.

"Q. Is that where the discharge into the cartridges, or to make the cartridges, occurs?

"A. That is correct" (R. p. 368).

It is sufficiently obvious that the machines designed by Mr. Davis in 1921 for handling plastic dynamite gelatine conformed generally with the dynamite gelatine packing machine of the Jones patent of 1907, which also employed helical screw conveyors for the same purpose.

The Respondent's Grease Guns.

All of this leads us to the grease guns which are alleged to have infringed the Baldner patent in suit, namely, the "Alemite Rock Crushers," one form of which is driven by compressed air and the other form of which is driven by an electric motor. The questions relative to the two forms are essentially alike. These machines are to some extent illustrated and described in Plaintiff's Exhibits 94, 95, 96, and 97 appearing at pages 507 to 519 of the record. The

structures themselves were put before the court in Defendant's physical Exhibits 30 and 33.

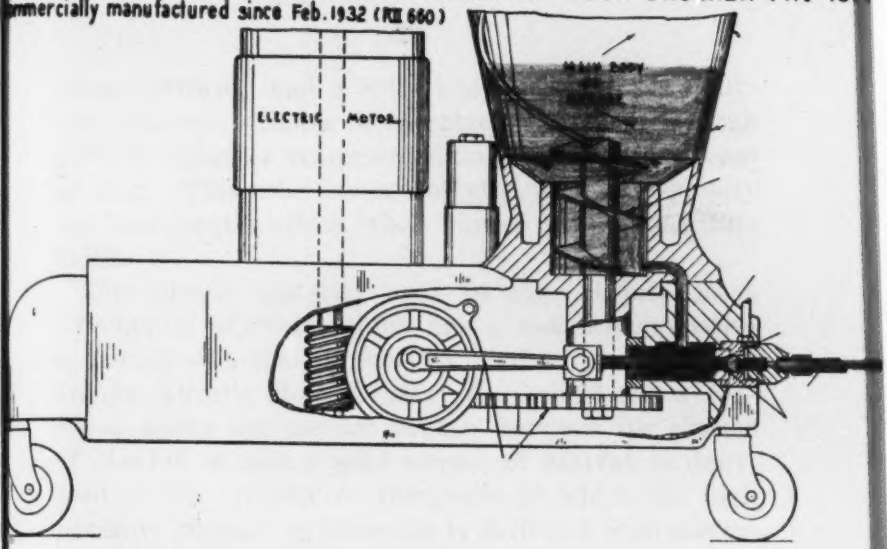
On an inserted page we have reproduced the cut with which the plaintiff-petitioner has chosen to illustrate the defendant's Rock Crusher grease gun. Immediately below it we have reproduced the figure of Battenfeld patent No. 678,635 of July 16, 1901. We have colored both cuts in conformity with the petitioner's coloration of its illustration of the device which is alleged to infringe the Baldner patent in suit.

The opinion of the Court of Appeals accurately and sufficiently describes the defendant's Rock Crusher grease gun. Like the device of the forty year old Battenfeld patent, it comprises a reservoir in which a helical screw conveyor is mounted to be rotated under power upon a vertical axis. A (red) power driven plunger or piston is reciprocated in a (purple) cylinder. As in the petitioner's illustration, we have colored in green the material in the reservoir in which the helical screw conveyor rotates and have colored in blue the material which is detached from the main body of material in the reservoir and ejected upon the forward stroke of the small high pressure piston.

Except as to inconsequential details of the driving gearing, etc., the defendant's device is identical with the Battenfeld device of 1901 both in construction, mode of operation and result. The Battenfeld device was designed primarily for use with one plastic material. The Alemite Rock Crusher was primarily designed for use with another plastic material. In the Battenfeld device, the reservoir was more or less completely filled with chunks of moist clay. The air pockets were worked out by the operation of the helical

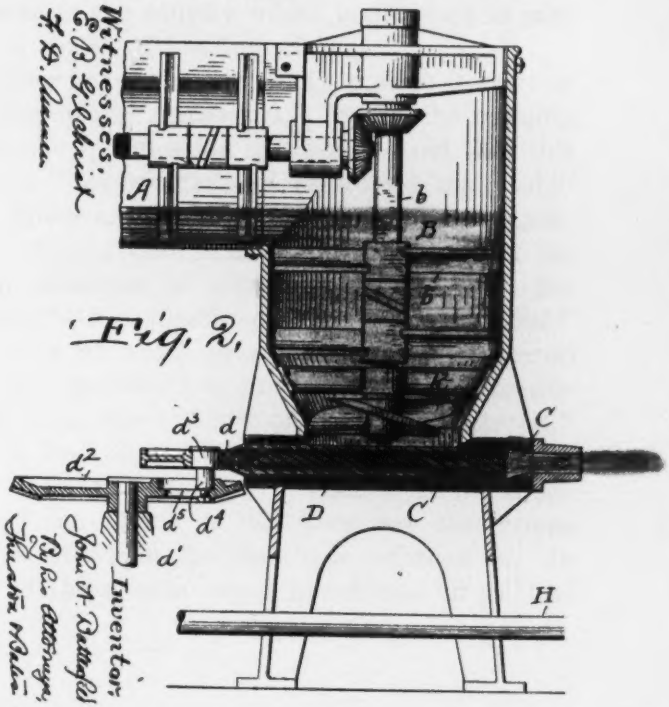
EFENDANT'S ELECTRICALLY OPERATED ROCK CRUSHER (R-I-481)

mmercially manufactured since Feb. 1932 (RII 660)



No. 678,635. Patented July 16, 1901.

J. N. BATTENFELD



screw conveyor and a solid body of clay was delivered into the cylinder or receptacle in which the high pressure plunger reciprocated to eject a solid stream of clay. This solid stream of clay was subsequently cut into lengths which when burned would constitute bricks.

The plastic material used in the Alemite Rock Crusher is Marfak, which has a consistency corresponding with that of the clay used in brick-making. In the Alemite Rock Crusher the helical screw conveyor works out the air pockets between the chunks of Marfak so that a solid stream of Marfak is delivered to the cylinder or receptacle in which the high pressure plunger reciprocates to deliver a solid stream of Marfak. In the Alemite Rock Crusher this solid stream of Marfak is delivered through the small steel armored hose to the coupler which is attached in succession to a series of bearing nipples.

The Baldner patent in suit (R. II, p. 683) is entitled "Grease Dispensing Apparatus," but in the opening sentence of the specification it is pointed out that this apparatus is "for plastic and semi-fluid materials" generally. There are two sentences in Baldner's specification in which grease is mentioned, but in each instance this reference to grease is coupled with the alternatives "other plastic or semi-fluid material." The two spots at which grease is mentioned are on page 2 of the specification, line 32, "actuated to discharge grease or other plastic or semi-fluid material," and page 2, line 69, "the grease or other plastic or semi-fluid material enters the cylinder." In the specification and the claims in suit there are thirty-four other places at which the plastic is referred to. In every one of these instances it is referred to as "the

material" or "the commodity." In all of the claims in suit it is invariably referred to as "the material."

In view of the fact that the defendant's Rock Crusher grease gun conforms exactly with the Battenfeld patent of 1901 as to all of the elements which are alleged to infringe the Baldner patent in suit, it would be impossible to give to the claims of the Baldner patent, which was not even applied for until 1921, such a construction or interpretation that they would be valid and at the same time infringed by the defendant's manufacture and sale of what is essentially the Battenfeld device of 1901.

This Brings Us to the Legerdemain by Which the Petitioner Seeks to Hide the Fact that the Baldner Patent in Suit Does Not Describe or Claim a Grease Gun at All, and by Which It Seeks to Hide the Fact that Even for What It Is the Baldner Patent Is Narrow in the nth Degree and of the Distinctly Paper Variety.

The plaintiff's answers to the defendant's interrogatories admit that the plaintiff has never manufactured or sold devices embodying the alleged invention of the Baldner patent, nor licensed others to manufacture and sell devices embodying it (R. pp. 642-3 and 645).

But the plaintiff's strategy is first to persuade your Honors by reiterated assertion that the Baldner patent is broadly and concededly and admittedly and judicially determined to be valid, and then to misconstrue the opinion and the grounds of the opinion of the Court of Appeals holding that there was no infringement of these broad and valid claims of the Baldner patent.

The petition asserts, at page 4, that the claims of the patent in suit are "admittedly valid." In a footnote on the same page, the petition explains this by saying:

> "Found valid by the Court of Appeals (R. II 1046)."

At page 7 of the petition, it is again stated that the claims are "admittedly valid" with a footnote asserting:

> "The Circuit Court of Appeals found the patent and claims in suit valid and refused to apply any prior art to anticipate or restrict the claims in any degree (R. II 1046)."

At page 10 of the petition, it is stated that:

> "The present status of the claims in issue is that they are valid and are unrestricted by any prior art."

At page 11 of the petition, it is stated that:

> "The Baldner claims in suit are valid and unrestricted by the prior art."

At page 15 of the petition, reference is made to the "unanticipated and admittedly valid patent claims" of the patent in suit.

At page 16 of the petition, it is asserted that the patent "has claims which are unanticipated and admittedly valid."

At page 23 of the supporting brief, reference is made to the "valid Baldner claims."

At page 24 of the supporting brief, it is asserted that:

> "The claims in issue are unanticipated and admittedly valid"

and again that:

> "The Baldner claims in suit are valid and unrestricted by the prior art."

At page 25 and running over to page 26 of the supporting brief, it is asserted that:

> "The claims in issue are unanticipated and admittedly valid."

The foregoing are all *assertions* by the plaintiff petitioner obviously designed and intended to lead the court to believe that the Baldner patent was held valid by the court below or that the Baldner patent was admitted and conceded by the defendant to be valid. Let us examine the record to see what the actual facts may be.

The defendant's answer denied validity of the Baldner patent and asserted numerous anticipating and limiting prior art patents and publications (R. I 19).

At the trial the prior art patents and publications were offered and received in evidence (R. I 417-443). These prior art patents and publications are reproduced in the record (R. II 679-1032).

At the conclusion of the trial, the district judge said:

> ". . . in the patents and other disclosures in evidence there are anticipations of the Baldner patent, if it is a combination of pumps for the purpose of moving grease or molasses" (R. II 665).

In the findings of fact and conclusions of law entered by the district judge, it is found:

> "If the Baldner claims be construed to cover the air or electric operated rock-crusher manufactured and sold by defendant the claims are invalid because anticipated by many patents and disclosures" (R. II 662).

In the decree entered by the district court, it is adjudged and decreed:

> "That the bill of complaint and both causes of action asserted therein be dismissed for want of equity" (R. II 667).

In the opinion of the Circuit Court of Appeals for the 7th Circuit, it was stated:

> "The defenses were invalidity and non-infringement" (R. II 1040).

and:

> "Having thus limited the patent to a metering or measuring device operating as Baldner described it, we find it unnecessary to pass upon the question of validity" (R. II 1045).

and:

> "Other questions are raised which bear on the question of validity. However, appellee admits no concern in the question of validity in view of our interpretation of the patent. While the district court held the patent was invalid even if there was infringement yet it cited no specific prior art upon which that judgment was passed. Under these circumstances we deem it unnecessary to express any opinion on the question of validity, and leave appellant with the benefit of the presumption which the issuance of the patent bestows upon it" (R. II 1046).

The judgment entered by the Circuit Court of Appeals for the 7th Circuit on December 5, 1940, adjudged and decreed:

> "That the decree of the said district court in this cause appealed from be, and the same is hereby affirmed with costs" (R. II 1046).

The fact is, therefore,—exactly contrary to the assertions made by petitioner—that the patent in suit

is not "admittedly valid." The fact is that it was not "found valid by the Court of Appeals." The fact is that the district judge found the patent was not infringed, and, further, that if it be so interpreted that its claims would include the defendant's machines, then it was "anticipated by many patents and disclosures" and was invalid. A decree was entered dismissing the complaint. The Circuit Court of Appeals agreed with the district court that the patent was not infringed, and therefore found it unnecessary to consider questions of validity of the patent. The judgment of the Circuit Court of Appeals *affirmed* the decree entered by the district court.

When, therefore, the petitioner states that the patent in suit is "admittedly valid" or that it was "found valid by the Court of Appeals," petitioner is obviously misstating the actual facts. The fact is that this case involved all of the usual issues of validity and infringement present in typical and ordinary patent infringement suits. And the fact is that, regardless whether valid or invalid, the Baldner patent is narrow in the nth degree.

As to the Defendant's Alleged Infringement of the Baldner Patent, the Strategy of the Petitioner Involves, First, the Presentation of the Baldner Patent as Something Wholly Other and Different from What It Really Is, and, Secondly, a Thoroughgoing Misrepresentation of the Grounds Upon Which the Court of Appeals Held that There Was No Infringement.

Never, throughout the petition or accompanying brief, do counsel call the Baldner device nor the parts of it by the names which the Baldner patent gives to

them. The petitioner's entire description of the Baldner device is presented in the nomenclature of the grease gun and lubricating art. The fact is that the Baldner patent itself says that it relates to a "dispensing apparatus for plastic and semi-fluid materials, and more particularly to measuring means therefor by which the discharge is regulated in measured quantity." (Specification, page 1, lines 9-13.) In its entirety the Baldner device stored a large quantity of plastic or semi-fluid material (of which grease was one example) and into which one could drop a suitable coin and have delivered to him in a pail or other receptacle, a predetermined quantity of plastic in graduated "units of measurement as pounds, or pints and quarts as desired and in accordance with the capacity of the rotary meter." (Specification, page 3, lines 5-8.)

What the Baldner patent describes as a rotary meter is described by the petitioner as the high pressure booster pump of a two-stage grease gun.

The real meaning of the opinion of the Court of Appeals is that each of the claims in suit of the Baldner patent includes and requires such a meter as one of its essential elements and that the defendant's grease gun contains no meter and, therefore, does not infringe.

Without going into any detailed consideration of the devious ways in which the petitioner has sought to conceal this simple fact, we should like now briefly to point out that a measuring device or meter is included as an essential element of each and every one of the claims in suit.

We shall refer first to claim 3 of the Baldner patent,—because this is the only claim to which the peti-

tioner gives any detailed consideration. This claim reads as follows:

> "3. In an apparatus of the character described, a reservoir, an ejector communicating therewith dividing the discharged material into successive charges of known capacity and conveyor means for supplying the material to the ejector in quantity greater than its capacity **whereby said ejector will act to impede the normal flow of the material under influence of the first ejector*** and will be operated at full capacity to discharge the material **in known measured quantity.**"

This claim 3 first calls for "a reservoir" and then for "an ejector communicating therewith dividing the discharged material into successive charges of known capacity." This is the element which the petitioner presents to Your Honors as constituting a small and very high pressure pump of a two-stage grease gun.

This same element is described in the other claims in suit as follows:

> *Claim 2*: In this claim two separate ejector mechanisms are described and then the one which the petitioner represents as being the high pressure pump of a two-stage grease gun is referred to as the second ejector. The language is:
>
> "two separate ejector mechanisms communicating therewith" (the reservoir) "and interconnected in series whereby one ejector supplies the other, the initial ejector being of greater capacity than the

---

* There is no antecedent in this claim for "the first ejector." The words are probably intended to refer to what the claim describes as "conveyor means." It is doubtless because of the uncertainties due to this lack of coherence within the claim itself that counsel for the petitioner have chosen this particular claim with which alone to practice their attempted legerdemain.

second ejector, **the second ejector acting to impede the normal output of the first ejector,** and discharging the material, **at lower pressure, . . . the quantity of discharge being measured** at the full capacity of the second ejector."

Claim 4: In this claim the part which the petitioner presents as being the high pressure pump of a two-stage grease gun is described as:

"an intermediate measuring chamber of known capacity communicating alternately with the pressure chamber, and with the discharge conduit for discharging the material from said pressure chamber **in measured quantity.**"

Claim 13: In this claim the element which is advanced by the petitioner as constituting the high pressure pump of a two-stage grease gun is:

"a flow regulating device controlling the discharge outlet **normally resisting the advance of material under influence of the ejector and permitting the escape thereof in measured quantity,**".

If now we turn to the specification and drawings of the Baldner patent to learn what is really meant by these words as they appear in these claims, we find this: The part which the petitioner represents as constituting the very high pressure pump or "booster" of a two-stage grease gun appears only in Figures 1, 2, 3 and 4 of Baldner's drawings and then only with the reference numeral 24. In the descriptive part of the Baldner patent beginning in line 56 of page 1 of the specification, this part is first referred to in line 51 of page 2. The language is:

"Leading from the pressure chamber 18 of the base or housing 2 is a discharge conduit 23. Located in this discharge conduit 23 is a rotary power driven **meter** 24, comprising the cylindrical

housing 25, having inlet and outlet passages 26 and 27 respectively. Mounted eccentrically within the circular housing 25 is a rotor 28 having therein two oppositely disposed overlapping sliding blades or vanes 29." Etc.

Elsewhere in Baldner's description where reference is made to this device, it is described over and over again as a meter. Thus:

Page 2, line 77:

"The capacity of the spiral conveyors 7 is greater than that of the **rotary meter** so that the material is always maintained in the pressure chamber 18 and supplied thence to the **rotary meter** under a relatively high pressure."

Page 2, line 89:

"The capacity of the spiral conveyors being so much greater than that of the **rotary meter,** insures at all times an ample supply of material under pressure at the inlet port of the **rotary meter.**"

Page 2, line 93:

"This supply under pressure in turn insures the intake chamber of the **meter** being fully and completely filled at a uniform pressure at each rotation of the rotor 28."

Page 2, line 101:

"The **rotary meter** is so designed that a predetermined number of rotations or predetermined number of charges shall equal exactly one pound or if units of liquid measure are desired, it is designed that a predetermined number of such charges shall equal one pint or one quart of the material."

Page 2, line 122:

"Thus the **rotary meter** is positively driven in unison with the actuation of the spiral conveyors 7."

Page 3, line 3:

> "The hub 39 of the worm gear carries the rotating arm 40, which plays over a circular disc, which may be graduated in units of measurement as pounds, or pints and quarts as desired and in accordance with the capacity of the **rotary meter.**"

Page 3, line 52:

> "That is to say, by starting the motor, when the contract arm 40 is upon one of these insulating inserts, the apparatus is designed to discharge one unit of material either a pound, a pint or some greater quantity, while the arm 40 is traveling to the next succeeding insert. In the drawings, but four inserts have been shown located in position ninety degrees from each other. This may be varied, however, according to the capacity of the **meter.**"

Now, what did Mr. Baldner or his patent solicitor say of this rotary meter 24, in persuading the Patent Office to grant him a patent? The "file wrapper" showing the details of the struggle which Baldner had with the Patent Office in order to secure the allowance of any patent at all, appears in the record at pages 561 to 615, inclusive. The claims of the Baldner application had been rejected as unpatentable. Thereupon Baldner replied to the Patent Office with this argument:

> "In view of the rejection of claims upon the reference Appel taken in connection with various patents showing a rotary pump, it is quite apparent that the Examiner has been misled by the apparent similarity of structure, without appreciating the difference in function and operation. While it is true the rotor 24 is *per se* a rotary pump of ordinary construction as shown in the references, **it is not employed in this instance as a pump and does not perform the function of**

a pump, but rather those of a rotary outlet valve. In the operation of the present construction, the conveyor screws, build up behind the outlet rotor, a high pressure, which ordinarily would be discharged through the outlet conduit in a continuous stream and under considerable pressure. The rotor 24 interposed in the conduit acts to impede or restrain this flow of material. The rotor is not used as a pump and is not necessary as a pump to move the material through the conduit. The material would move through the conduit much faster and with greater quantity under the unrestrained influence of the conveyor screws, if the rotor 24 was omitted. The rotor 24 although a pump in construction does not perform the functions of a pump, but rather those of a rotary outlet valve, which retards and reduces the flow instead of operating as a pump to increase it. However, it does more than a mere rotary valve in that it controls the output in measured quantity. . . . The material in the discharge conduit and that in the measuring valve chamber or pump chamber is not subject to the high pressure developed by the screw conveyor. Consequently the propulsion of material through the conduit is entirely independent of the propulsion of the material and pressure developed by the screw conveyor. It is this independence of operation and the alternate connection of the intermediate rotary regulating valve with the high pressure chamber 18 and with the discharge conduit, and the measured discharge and reduced pressure, and the impediment or restraint imposed by this rotary member upon the discharge from the conveyor screws clearly distinguishes the present construction from the reference Appel.

". . . Appel had before him the problem of packing the material under high pressure into a container. His problem did not involve the question of measured quantity, but rather that of regulated pressure. To the contrary applicant's problem is that of discharging in measured quantity, rather than at high pressure. Appel's con-

struction was designed to augment or step up the pressure by arranging the screws in tandem and affording continuous feed. Applicant's construction steps down the pressure or discharges at less pressure than that developed by his initial compressor screws and moreover the feed is not continuous, but the rotor interrupts the discharge so that the discharge conduit is not subjected to a higher pressure, but rather to a lower pressure than that developed by the conveyor screws. **These distinctions are thought to be brought out in the claims amended as follows:"**

The amendments then made in claims 2, 3 and 4 in suit, in order to incorporate the foregoing distinctions into the claims themselves, were as follows:

"Claim 2, line 5, after 'ejector' insert—

B2 the second ejector acting to impede the normal output of the
first ejector, and discharging the material, at lower pressure—

"Claim 3, line 4, after 'ejector' insert—

B3 will act to impede the normal flow of the material under in-
Per C fluence of the first ejector* (AND)—

"Claim 4, line 4, after *'pressure' insert—a discharge conduit—*
same line, erase *'ejector'* and insert—*intermediate measuring chamber—*
same line, after 'capacity' insert—

B4 communicating alternately with the pressure chamber, and with
the discharge conduit for—

last line, erase the period and add—in measured *quantity—*

(Rec. II, pp. 592-4.)

* Matter in parentheses inserted." (R. pp. 592-3-4.)

Claim 13,—incorporating the same distinctions, was not presented to the Patent Office until a later date (R. pp. 600 and 604), at which time it was said by Baldner's solicitor:

> "Claims 12 and 13* (AND 14) are distinguished from the references for the same reasons pointed out in connection with claims 1 to 6, inclusive." (R. p. 605.)

The Patent Office examiner had, in rejecting certain of Baldner's claims, cited the case of *Ex parte McNeil*, 1902 C. D. 313. In attempting to answer the Patent Office objection based upon the McNeil case, Baldner, through his solicitors, said:

> ". . . The McNeil case involved a claim for a specific form of stitch mechanism complete in itself and operative independent of the trimmer and a form of trimmer also complete in itself and operated independent of the stitch forming, mechanism. That is to say, the McNeil decision referred to a claim containing two entities completely operative independent of each other to perform all their functions. This is not the case in the present instance. The measuring and dispensing apparatus set up in the claim is incomplete without driving means, and the driving means is impractical and inoperative without means for starting and stopping it. In other words, the dispensing apparatus with its measuring features is dependent upon means for starting and stopping it after a definite periods or cycles of operation. Likewise the commutator control device adjustable for different cycles of operation is incomplete and inoperative without means for actuating it, which forms a necessary part of the dispensing apparatus, which it controls. In the case under consideration, *Ex parte McNeil*, the trimmer could be wholly removed and the stitch forming mechanism would perform its every function. Likewise

the stitch forming mechanism if removed would leave the cutter in condition to perform its every function. In the present case if the controller is taken off the dispensing apparatus will not perform its function, it will not operate for definite or predetermined periods, it will not automatically stop at the end of such period, and on the other hand if the dispensing apparatus, and its necessary driving motor is taken away, the controller becomes merely junk and entirely without purpose or function. There is therefore, an interdependence between the elements of the claim in the present case which was not present in the claim considered in *Ex parte McNeil.* . . ." (Rec. pp. 595-6.)

In the same argument and amendments, Baldner said, relative to another prior art patent, *i.e.*, Pressler:

". . . There is another important feature, and that is that Pressler controls his discharge solely by the period of motor operation or by the time element and not by any actual measurement of quantity. It is to be noted that all, or nearly all of **the claims** 7 to 16 *include the feature of discharging the commodity in measured quantity,* as by the rotary measuring discharge valve apart from the period control of the electrical connection. Pressler has no means of quantity measurement corresponding *to applicant's rotary measuring valve or measuring ejector pump, which is a part of each of the claims."* (Rec. p. 596.)

Despite these arguments, the Patent Office Examiner again rejected all of Baldner's claims (R. pp. 598-9); whereupon a further amendment and argument were presented on behalf of Mr. Baldner wherein it was said:

". . . **Applicant's device discharges at a lower pressure than that within the machine. In the**

reference the pressure is gradually increased, and the point of highest pressure is at the discharge end of the packing augur, or outlet, whereas applicant's device *(DE) ~~in~~creases the flow of material under the accumulated pressure within the chamber and permits it to escape in measured quantities at a lower pressure. This difference is brought out in claim 2, wherein the second ejector is described in the insert, as acting to impede the normal output of the first ejector and discharge the material at a lower pressure. For this reason,** claim 2 is thought to be fully and clearly distinguished from the reference Apple as well as the remaining references of record. Applicant has been unable to discover in any reference a suggestion that the material **is discharged in measured quantities but at a lower pressure than that created by the ejector means.** If the rejection is to be insisted upon, it is requested that the Examiner point out in the references the corresponding construction.

"Claim 3, line 2, after 'therewith' insert—dividing the discharged material into successive charges—

line 4, before 'will' and following the previous insert insert—and—

"Claim 4 is thought to be distinguished from the references by specifying an intermediate measuring chamber in the discharge conduit, which communicates alternately with the pressure chamber and with atmosphere. That is to say, the rotary flow regulator which the Examiner designates as a rotary pump embodies a measuring chamber which communicates with a pressure chamber, and is cut off from the discharge conduit until the measuring chamber is completely filled, whereupon the measuring chamber is cut off from the pressure chamber and is opened into the conduit. Certainly the pressure

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"* Matter in parentheses inserted.

augur of Apple has no such alternating relationship **and does not measure the supply. The augur of Apple is a pressure creating device only and not a measuring device. By setting forth the measuring chamber** and particularly by designating this measuring chamber as opening alternately, to the pressure chamber to receive a charge, and then separating from the pressure chamber and opening to the conduit to discharge the measured charge distinguishes from the *(CONTINUOUSLY) ~~previously~~ operated augur 7[a] of Apple, as well as the other devices of the references.

. . . . . .

". . . If applicant has adapted a rotary pump to a different and unusual use, making application of the rotary pump principle, for accomplishing a different result from that ordinarily accomplished by a rotary pump, this should not preclude applicant from the allowance of a claim for **this application of an old device to a new use.** The record of this case does not show and the Examiner has pointed out no instance **wherein a rotary pump is used as a pressure reducer, or a regulator resisting a high head pressure, and discharging the commodity at a lower pressure. This is just the converse of the ordinary use and application of a rotary pump. In the present case the rotary pump structure is employed to measure quantity** by insuring that the pump chamber is filled to capacity each time. **This is insured by building up a high head pressure within the pressure chamber. The rotary pump structure does not perform any pumping operation whatsoever. If pump blade was removed, the commodity would flow through the discharge conduit much faster and perhaps in greater quantity than it flows during the operation of the rotary pump regulator. The rotary pump pressure is used in this case not as a pump, but as a pressure resisting**

"* Matter in parentheses inserted." (R. pp. 601-3.)

device and a measuring device. To adapt an old device to *(A NEW) ~~an old~~ use is just as much invention as to devise an entirely different structure, for *accomplishing an old result.*

It was as a part of this later amendment that claim 13 of the patent in suit was presented for the first time and relative to which Mr. Baldner's attorney said that it was "distinguished from the references for the same reasons pointed out in connection with claims 1 to 6, inclusive" (R. p. 605).

In quoting the foregoing amendments and arguments which were advanced by or on behalf of Mr. Baldner in order to secure the grant of any patent at all, we have emphasized many passages in which it was urged that the language of Baldner's claims was such as to distinguish them from the various references of the prior art. **For the same identical reasons, every one of the distinctions which was urged and relied upon to distinguish Baldner's claims from various devices of the prior art, distinguishes the defendant's Rock Crusher grease guns from what was said to constitute the subject matter of the claims which finally became claims 2, 3, 4, and 13 of the Baldner patent in suit.**

Without reviewing in detail the distinctions which Baldner made and relied upon, it will suffice to say that in the defendant's Rock Crusher grease guns:

1. The defendant's high pressure reciprocating plunger pump is employed as a pump and performs the function of a pump, not that "of a rotary outlet valve."

2. In the defendant's grease gun, the conveyor screw does not build up a high pressure, but only a low pressure of two or three pounds per square inch. The pressure developed by the conveyor screw is entirely

inadequate to force any grease through the discharge hose since, by Mr. Clapp's own admission, a pressure of from 500 to 1,000 pounds per square inch is required merely to move the grease through this hose (R. pp. 29-30).

3. In the defendant's Rock Crusher the grease could not "be discharged through the outlet conduit in a continuous stream and under considerable pressure" by the conveyor screw alone.

4. In the defendant's Rock Crusher the high pressure reciprocating pump is not interposed in the outlet conduit to impede or restrain the flow of material under the pressure developed by the conveyor screw.

5. In the defendant's Rock Crusher the small reciprocating plunger pump is used as a pump and as a pump only, and it is necessary to act as a pump to move the material through the conduit.

6. In the defendant's Rock Crusher "the material would *not* move through the conduit much faster and with greater quantity under the unrestrained influence of the conveyor screws if the" high pressure reciprocating plunger pump "was omitted." It would not move at all.

7. In the defendant's Rock Crusher the small reciprocating plunger pump *does* perform the functions of a pump and not those of a rotary or other outlet valve. It does *not* retard and reduce the flow instead of operating as a pump to increase it.

8. The defendant's high pressure reciprocating plunger pump is not a rotary valve at all and it does not control the output in measured quantity.

9. In the defendant's Rock Crusher grease gun the problem was *not* that of discharging in measured quantity. The object and purpose was rather to discharge

unmeasured quantities but at extremely high pressures, i.e., in excess of 5,000 pounds per square inch.

10. The distinctions which were brought out in the claims in order to differentiate from the prior art, distinguish also from the construction and mode of operation of the defendant's Rock Crusher grease guns.

11. The defendant's Rock Crusher grease gun does *not* discharge the commodity in measured quantity.

12. The defendant's Rock Crusher grease gun does *not* have in it any "rotary measuring valve or measuring ejector pump, which is a part of each of the claims" of the Baldner patent.

13. As compared with claim 2 of the Baldner patent, the defendant's Rock Crusher grease gun does not have a "second ejector acting to impede the normal output of the first ejector and discharge the material at lower pressure." In the defendant's Rock Crusher the screw conveyor does not develop sufficient pressure to cause any output whatsoever, and the high pressure reciprocating plunger pump does not discharge the material at a lower pressure, but rather at a pressure more than one thousand times greater than that developed by the screw conveyor.

14. In the defendant's Rock Crusher grease gun the material is not "discharged in measured quantities" or "at lower pressure than that created by the" screw conveyor.

15. The defendant's Rock Crusher grease gun is like the prior art patent to Apple in that it "does not measure the supply." The defendant's high pressure reciprocating plunger pump is like the augur of Apple in that it "is a pressure creating device only, and not a measuring device."

16. As distinguished from Baldner's alleged "application of an old device to a new use," the defend-

ant's Rock Crusher grease gun involved merely the application of an *old* device to an *old* use.

17. In the defendant's Rock Crusher grease gun the high pressure reciprocating plunger pump is *not* used as a pressure reducer or as a regulator, resisting a high head pressure and discharging the commodity at a lower pressure; exactly the reverse is true of the defendant's device.

18. The defendant's Rock Crusher grease gun makes the ordinary use and application of a high pressure reciprocating plunger pump, just as Apple used his high pressure pump. The defendant does not employ "the converse of this ordinary use and application."

19. The defendant's grease gun is *not* employed to measure quantity.

20. In the defendant's device quantity measurement is *not* insured by building up a high head pressure within the pressure chamber. In the defendant's device the head pressure is very low,—only three pounds per square inch (Rec. I, pp. 222-3), as contrasted with pressures in excess of 5,000 pounds per square inch in the grease delivered by the defendant's high pressure reciprocating pump.

21. It is not true of the defendant's Rock Crusher grease gun, as it was said to be true of Baldner's device, that the "pump structure does not perform any pumping operation whatsoever." In the defendant's device the whole of any grease discharging function is performed by the high pressure reciprocating plunger pump.

22. If in the defendant's Rock Crusher grease gun the plunger of the high pressure reciprocating pump were removed, the commodity would *not* flow through the discharge conduit at all, to say nothing

of its "flowing faster and perhaps in greater quantity than it flows through the operation of the high pressure reciprocating pump."

23. In the defendant's grease gun the high pressure reciprocating pump *is* used as a pump. It is *not* used "as a pressure resisting device and a measuring device."

It is clear beyond peradventure, therefore, that Baldner secured the allowance and grant of his patent only by urging the distinctions between his metering and measuring valve and the pressure producing pumps of the prior art. Furthermore, he repeatedly amended his claims in such a way as to incorporate language which was then urged as making this very distinction.

Baldner's claims 2, 3, 4, and 13 distinguish, therefore, from the defendant's grease gun in precisely the same way as that in which these claims were urged upon the Patent Office as distinguishing from the prior art. It is needless to say to this court that one cannot secure the allowance of patent claims by incorporating in them various words to distinguish from the prior art, and then to have these distinctions disregarded when attempting to enforce the patent against a defendant whose device conforms with the prior art from which the distinctions were made.

Roemer v. *Peddie,* 33 L. Ed. 313, 317; 132 U. S. 382, 384 (Mr. Justice Blatchford):

> "This court has often held that when a patentee, on the rejection of his application, inserts in his specification, in consequence, limitations and restrictions for the purpose of obtaining his patent, he cannot, after he has obtained it, claim that it shall be construed as it would have been construed if such limitations and restrictions were not contained in it."

(See also: *Smith* v. *Magic City Kennel Club,* 282 U. S. 784, 789, 790; 75 L. Ed. 707, 712, 713. *Keystone Driller Company* v. *Northwest Engineering Corporation,* 294 U. S. 42, 48; 79 L. Ed. 747, 751.)

This Brings Us to a Consideration of the Grounds Upon Which the Court of Appeals Held that the Defendant Had Not Infringed Claims 2, 3, 4 or 13 of the Baldner Patent.

The opinion of the Court of Appeals concludes its description of the Baldner device by saying that:

> "At its lower end the vertical shaft carries a gear pinion meshing with a similar pinion upon a stub shaft carried by one of the spiral conveyors, thus driving the rotary meter and the spiral conveyors in unison." (R. II, p. 1042.)

It then goes on to say that the further "lengthy description" of the Baldner patent "specifically describes the means by which the predetermined amount of the material desired by the purchaser may be delivered to him immediately by either manually operating a switch to start the motor or by a coin-controlled means by which the switch is closed upon the insertion of a coin of proper size." (R. II, pp. 1042-3.)

The plaintiff's petition is drawn in such a way as to give the impression that it was because Baldner did not include in his claims the hose and the coupler and the lubricant fitting of an automobile lubricating system that the Court of Appeals held that the defendant did not infringe. There is, of course, no warrant for any such misunderstanding or misrepresentation of the opinion of the Court of Appeals,—particularly since the Baldner patent says absolutely nothing about the hose or the coupler or the lubri-

cant fitting of an automobile lubricating system, nor indeed about the grease gun part of such a system. In the absence of any disclosure of any such things in his specifications and drawings, Baldner could not, of course, have included such things in any of his claims. The best that the petitioner can do, therefore, is to couple the intimation that the Court of Appeals attempted to include such things in Baldner's claims by referring to those parts of the Court of Appeals' opinion in which reference is made to the specifications generally of the Baldner patent.

The petitioner's assertion is that the Court of Appeals did construe Baldner's claims in such a way as to include within them all of the details of the descriptive part of the specification. But the Court of Appeals expressly answered any such contention as this by saying:

> "It is suggested by appellant" (the plaintiff, Clapp) "that it is not necessary for us to consider this part of Baldner's disclosure" (having to do with "the means by which the predetermined amount of the material desired by the purchaser may be delivered to him immediately by either manually operating a switch to start the motor or by a coin-controlled means by which the switch is closed upon the insertion of a coin of proper size") "because it is not contended that appellee has infringed this particular feature. **This, indeed, is quite true.** . . ."

This means that the Court of Appeals expressly agreed with the Petitioner in the very matter upon which the Petitioner now bases its complaint to this court.

The Court of Appeals went on immediately to say that:

"While it is not necessary to set forth this par-

ticular specification," (relative to the manual or coin-controlled means for operating the switch to start and stop the motor) "yet it is quite proper for us to consider the entire specification in order to determine the real content of Baldner's **claims.**

"The claims in issue[1] disclose a combination whose elements are conceded to be old in the art. It" (the combination of elements enumerated in Baldner's claims) "is a lubricant-vending machine, pure and simple." (R. II, p. 1043.)

This was obvious because each and every one of Baldner's claims included as one of its elements a so-called second ejector,—which by reference to the specification was found to be the "rotary **meter** 24."

This "rotary meter 24" (page 2, line 91) of the Baldner patent was not described as including any indicating means whatsoever. The indicating mechanism was something wholly separate and distinct from "the rotary meter 24." Baldner described this indicating mechanism as follows:

"In order to indicate the quantity of material discharged, the shaft 36 of the rotor 28 is extended laterally as shown in Fig. 3, and carries a worm (not shown) meshing with the worm gear 37. This worm gear 37 is suitably mounted upon a standard or post 38, in this instance mounted upon the top of the pressure chamber 18. The hub 39 of the worm gear carries the rotating arm 40, which plays over a circular disc, which may be graduated in units of measurement as pounds, or pints and quarts as desired and in accordance with the capacity of the rotary meter. Thus by watching the travel of the arm 40, the operator may know how much material has been discharged." (page 2, line 125, *et seq.*—R. II, pp. 684-5.)

The "rotary meter 24" of the Baldner patent did not, therefore, comprise or include any dial or gauge or

pointer or other indicator of quantity. The "rotary meter 24" of the Baldner patent was the thing which did the measuring. It was the measuring device itself. It was this measuring device itself, *i.e.*, the "rotary meter 24" which Baldner presented to the Patent Office as having a function, mode of operation, and result entirely different from that of a pressure increasing pump. It is, however, the thing which the petitioner now presents to this Court as being the same as, or the equivalent of, the pressure producing pump of the defendant's Rock Crusher grease gun.

Baldner's various claims described in greater or less degree the characteristics and functions of "the rotary meter 24" of the Baldner specifications, as, for example in claim 2 "the second ejector acting to impede the normal output of the first ejector, and discharging the material, at a lower pressure . . . the quantity of discharge being measured at the full capacity of the second ejector"; in claim 3, "an ejector communicating therewith dividing the discharged material into successive charges of known capacity," etc., "whereby said ejector will act to impede the normal flow of the material under influence of the first ejector and will be operated at full capacity to discharge the material in known measured quantity"; in claim 4, "an intermediate measuring chamber of known capacity communicating alternately with the pressure chamber, and with the discharge conduit for discharging the material from said pressure chamber in measured quantity"; and in claim 13, "a flow regulating device controlling the discharge outlet normally resisting the advance of the material under the influence of the ejector and permitting the escape thereof in measured quantity, and means for actuating the regulator in accordance

with the quantity of material advanced by the ejector means."

After agreeing with counsel for the petitioner that it was "indeed quite true" that it was not necessary for the court to consider the part of Baldner's disclosure which had to do with his manually operated or coin-controlled switch to start and stop the motor in order to determine the question of infringement of claims 2, 3, 4, and 13 of the Baldner patent, and after pointing out that **the combination claims of the Baldner patent describe a "lubricant-vending machine, pure and simple,"** the opinion of the Court of Appeals described the defendant's Alemite Rock Crusher grease gun and then went on to state some of the Court's reasons for finding and holding that the defendant's grease gun was not a lubricant-vending machine at all.

We have seen that claim 2 of the Baldner patent required that "in an apparatus of the character described" the second ejector means shall act to impede the normal output of the first ejector and to discharge the material, at lower pressure, the quantity of discharge being measured at the full capacity of the second ejector. It was in order to contrast the defendant's grease gun with any such metering dispenser as this and for this reason only that the Court of Appeals pointed out that in the defendant's high pressure lubricating system on its forward movement the plunger of the high pressure lubricating pump "drives the grease in the cylinder through an outlet valve (through which the grease cannot return), into a hose which is equipped at its forward end with a coupling member for attachment to the fittings of the bearing to be lubricated. Continued operation of the motor will pump grease through the hose into the fit-

ting through which the automobile bearing is lubricated."

As we have said, it was Mr. Clapp, the plaintiff, himself, who pointed out in his testimony that it required a pressure of from 500 pounds to 1,000 pounds per square inch merely to move the grease through this small hose and coupler (Rec. I, pp. 29-30). It was the plaintiff's own witness, Mr. Woodling, who determined and demonstrated that the pressure developed by the screw conveyor of the defendant's grease gun was only 1½ to 3½ pounds per square inch (Rec. I, pp. 222-3). What the Court of Appeals was saying, therefore, was that in the defendant's device the grease was not discharged "at lower pressure," but rather at higher pressure, and that in the defendant's device the high pressure reciprocating pump did not act to impede the normal output of the first ejector and that, indeed, the first ejector, *i.e.*, the helical screw conveyor, would have no normal output whatsoever through the long slim hose and coupler of such a lubricating system as that of the defendant.

The opinion of the Court of Appeals was pointing to similar distinctions between the defendant's device and the similar language of the other claims in suit. In this connection and for the same purpose of pointing out the contrast between the subject-matter of Baldner's claims and the defendant's grease gun, the Court of Appeals went on to say that in the defendant's device

> "there is no meter or gauge of any kind included in the structure which is used or usable to measure the quantity of grease discharged, and in lubricating a car there is no way of knowing how many cubic inches of lubricant may be used."

In brief, the defendant's device contains no meter.

Every one of the four claims in suit of the Baldner patent included a meter as one of its essential elements.

Further referring to the defendant's grease gun, the opinion of the Court of Appeals goes on to say:

> "In these devices the worm or screw in the reservoir advances the grease slowly and under very low pressure of not more than three pounds per square inch into the cylinder of the high pressure lubricating delivery pump. . . ."

This was, of course, to be contrasted with the combinations of elements set forth in the claims of the Baldner patent wherein the worm or screw was described as being of greater capacity than the second ejector which in turn acted to impede the normal output of the worm or screw and discharged the material at lower pressure (claim 2); and wherein the worm or screw was described as means for supplying the material to the ejector in quantity greater than its capacity, whereby said ejector will act to impede the normal flow of the material "under influence of the first ejector," which was probably intended to mean the worm or screw (claim 3); and wherein the worm or screw was described as "means for discharging the contents of the reservoir into said chamber **under pressure**" from which the material was discharged by the meter in measured quantity (claim 4); and wherein the worm or screw was described as "an ejector means therefor advancing the material **under pressure**" and from the outlet of which the material was not permitted to be discharged as it otherwise would be discharged because of the interposition in the discharge conduit of a flow regulating device controlling the discharge outlet normally resisting the advance of material under the influence

of the worm or screw and permitting the escape thereof only in measured quantity (claim 13).

It was after pointing out these distinctions between the defendant's grease gun and the characteristics and functions of the screw conveyor and the meter, as set forth in the claims of the Baldner patent, that the Court of Appeals went on to say:

> "It is clear that the patented device is not infringed by the accused structures. They do not perform the same functions, and the means and results are entirely different. It was pointed out by the District Court that in the patented article the greater pressure was in the upper chamber, and the lesser pressure was in the lower chamber, while in the accused structure it is just the reverse. Great pressure is not necessary in the operation of the patent, for the inventor was only concerned in delivering the measured amount into any receptacle of the purchaser's choosing. A different problem, however, confronted appellee, for its object was to deliver the grease to the different bearings in the automobile through a hose, and this admittedly requires a great deal of force. Appellee was not concerned with the exact amount that it was delivering for the benefit of the purchaser. Its object was to deliver whatever was necessary for greasing the bearings, and no one could tell how much that would be. Under these circumstances a meter was not necessary to accomplish appellee's objects, and the accused devices have no such means." (R. II, p. 1045.)

The opinion of the Court of Appeals then took up the plaintiff's contention, as advanced in the Court of Appeals, that the defendant's grease gun does contain the equivalent of a meter because "when the lower chamber is filled to its capacity with grease from the upper chamber, that constitutes a measured

amount in the lower chamber; and as this amount is thus separated from the upper chamber it is in that sense a measured amount and reads upon the claims of the patent." (R. II, p. 1045.) The Court of Appeals then gave its reasons why it could not accept this interpretation, saying finally:

> "When these claims are read and interpreted in the light of Baldner's specification and description, it is obvious that they do not read upon the accused structures." (R. II, p. 1045.)

This last quoted sentence of the opinion of the Court of Appeals is one of the two sentences to which the petitioner mainly directs its pretended criticism, the petitioner seeking in this connection to convey the impression that the Court of Appeals herein attempted to substitute the entire specification and description of the Baldner patent for the subject matter of the claims in suit of the Baldner patent. However, it is to be observed that what the Court of Appeals really referred to was "these claims" "when" "read and interpreted in the light of Baldner's specification and description." (R. II, p. 1045.)

The next succeeding paragraph of the opinion of the Court of Appeals provides the other sentence upon which the petitioner mainly bases its pretended criticism. This paragraph reads as follows:

> "Having thus limited the patent to a metering or measuring device, operating as Baldner described it, we find it unnecessary to pass upon the question of validity. Because of the lack of infringement, the District Court dismissed the complaint for want of equity. Assuming without conceding that the accused structures, so far as they go, use precisely the same means as the patent uses, yet appellee could not be held for infringement, for Baldner has no patent on any-

> thing less than his entire combination." (R. II, pp. 1045-6.)

Obviously Baldner's "entire combination," as the phrase was here used by the Court of Appeals, meant **the entire combination set forth in Baldner's claims,** —exactly what had last been mentioned at the close of the preceding paragraph, namely, the claims of the Baldner patent when "read and interpreted in the light of Baldner's specification and description," and what the opinion of the Court of Appeals had previously referred to when it said that "the claims in issue disclose a **combination.**" It was manifestly the entire combination as set forth in Baldner's claims 2, 3, 4, and 13 in suit to which the Court of Appeals was addressing itself when it said that Baldner has no patent on anything less than his entire combination.

As we have seen, one element of each and every one of the claims in suit was a meter. Any infringing structure would, therefore, necessarily include a meter as one of its elements. The defendant's grease gun did not include any meter. Nothing less than the entire combination of the claims in suit could infringe. Therefore, there was no infringement.

The Court of Appeals used the following phraseology:

> "Assuming without conceding that the accused structures, so far as they go, use precisely the same means as the patent uses."

What did this mean? The petitioner says, in effect, that the Court of Appeals assumed in holding noninfringement that the defendant's accused structures did use all of the elements of all of the four claims in suit. And the petitioner says, in effect, that it was only those elements of the entire Baldner device

which were not included in any of the four claims in suit which were not to be found in the defendant's grease gun. This is an absurd and wholly unjustified misunderstanding of the opinion of the Court of Appeals. What the Court of Appeals meant was clearly this: that even assuming that the accused structures contain some of the elements **of the claims in suit,** they did not include all of the elements **of any claim.**

Thus, for example, it might be assumed that the defendant's grease guns did contain such elements of the claims as the following: Claim 2: "a supply reservoir"; claim 3: "a reservoir, an ejector communicating therewith"; claim 4: "a reservoir, an auxiliary pressure chamber communicating therewith"; claim 13: "a reservoir and an ejector means therefor," etc. It might very properly be assumed or conceded that the defendant's grease guns do, as far as they go, incorporate these elements of these claims. But the inclusion of anything less than all of the elements of a patent claim means non-infringement.

The opinion of the Court of Appeals said and held merely that there was no infringement because the defendant's grease guns did not embody all of the elements of any of the claims in suit.

As to the propriety of reading and interpreting Baldner's claims in the light of Baldner's accompanying specification and description, we need refer to only a few of the many, many decisions of this Court which specifically approve that very method as the only proper method of construction and interpretation.

American Fruit Growers, Inc., v. *Brogdex Company,* 283 U. S. 6; 75 L. Ed. 804 (decided March 2, 1931—Opinion by Mr. Justice McReynolds):

"'The claim of a patent must always be explained by and read in connection with the specification.' *Carnegie Steel Co.* v. *Cambria Iron Co.,* 185 U. S. 403, 432, 46 L. ed. 968, 984, 22 S. Ct. 698."

Hamilton Bates et al. v. *Charles W. Coe,* 98 U. S. 31, 38; 25 L. Ed. 68, 70 (decided November 25, 1878—Mr. Justice Clifford delivered the opinion of the court):

"Cases arise not unfrequently, where the actual invention described in the specification is larger than the claims of the patent; and in such cases it is undoubtedly true that the patentees in a suit for infringement must be limited to what is specified in the claims annexed to the specification, but it is equally true that the claims of the patent, like other provisions in writing, must be reasonably construed, and in case of doubt or ambiguity it is proper in all cases to refer back to the descriptive portions of the specification to aid in solving the doubt or in ascertaining the true intent and meaning of the language employed in the claims; nor is it incorrect to say that due reference may be had to the specifications, drawings and claims of a patent, in order to ascertain its true legal construction. *Brooks* v. *Fisk,* 15 How. 215."

Carnegie Steel Company, Limited v. *Cambria Iron Company,* 185 U. S. 403, 432; 46 L. Ed. 968, 984 (decided May 5, 1902—Statement by Mr. Justice Brown):

". . . The second claim apparently extends to the art of mixing all molten metals, but the specification, taken in connection with the disclaimer, which describes a process designed to dispense with the use of cupolas, shows that it was intended to include metal tapped from blast furnaces, and was probably intended to be limited to that. Whether the claim would be void if con-

strued to include cupola metal it is unnecessary to consider. It clearly includes metal from blast furnaces, and is not rendered void by the possibility of its including cupola metal. The claim of a patent must always be explained by and read in connection with the specification, and as this claim clearly includes metal taken from blast furnaces, the question whether it includes every molten metal is as much eliminated from our consideration in this case as if it were sought to show that the word 'metal' might include other metals than iron. . . ."

Turrill v. *Michigan Southern & Northern Indiana Railroad Co.*, 68 U. S. 491, 511; 17 L. Ed. 668, 673 (Apr. 11, 1864—Opinion by Mr. Justice Clifford):

"Evidently, the claim must be construed in connection with the explanations contained in the specification, and when viewed in that light, it is quite clear that it should receive a more restricted construction than was given to it in the charge of the court. Special devices are described as combined and arranged in a particular manner, and operate only in a special and peculiar way for a special purpose, and to effect a special result. Obviously, it is not a claim for any kind of movable press-block, combined and operating in any way with any kind of fixed block, to accomplish any purpose or effect any kind of result. Giving that construction to the claim, then indeed it would be true that the plaintiffs, when they admitted that movable press-blocks, in combination, with faces of various shapes and used for various purposes, were older than the invention of the patentee, did admit away their whole case and, if viewed in that light, it would be equally true that there was no question of fact to be submitted to the jury. But such is not the true construction of the patent, as is obvious from every one of the explanations of the specification. Invention was of such a mov-

able press-block as is described, having its edge formed to the side of the rail in combination with such other block as is described, with its edge of similar but reversed form arranged as described, and combined and operating in the particular way described, for the special purpose of effecting the described result."

As a matter of fact, the very cases cited by the petitioner on pages 15 and 16 in support of the proposition "that the claims of a patent define and measure the patented invention and the scope of the patent monopoly rather than the 'entire specification,'" almost without exception refer also to the equally well established rule of construction that the claims of a patent are to be read and interpreted in the light of the accompanying specifications. No one does or could question the proposition that it is the claims of a patent which define and measure the patented invention and the scope of the patent monopoly rather than the entire specification.

To examine briefly the cases cited by the petitioner:

(1) *Continental Paper Bag Co.* v. *Eastern Paper Bag Co.*, 210 U. S. 405.

The portion of this case upon which the petitioner relies appears on page 36 of the petition. In this case the Supreme Court held that the invention was a broad one. The claims which the court was called upon to interpret included means for doing such and so, and in that connection the court held that the claims were not limited to the precise structure shown in the specifiiation. That is what the court was referring to in the part quoted by the petitioner at page 36. Immediately following this quotation, the court quotes at pages 418 and 419 from Robinson on Patents the following:

> "The principle of the invention is a unit and invariable; the modes of its embodiment in the concrete invention may be numerous and in appearance very different from each other."

From this it is clear that while the claims do measure the invention, the claims cannot be construed to vary from the principle of the invention.

(2) *Leeds and Catlin* v. *Victor Talking Machine Company,* 213 U. S. 301.

There is nothing in or about this case which is inconsistent with our position in this suit. The portions of the decision quoted on pages 34 and 35 of the petitioner's brief merely state the proposition that the several claims are for inventions. There is nothing inconsistent in this language with our position that all of the claims, even though they be independent inventions, must be construed in the light of the specification.

(3) *Altoona Theaters* v. *Tri-Ergon Corporation,* 294 U. S. 477.

This case merely holds that the claims of a patent may not be narrowed and perhaps validated by reading into them other parts of the specification. The quotation on this point is as follows (p. 487):

> "As none of the flywheel claims as drawn define an invention, none can be aided by reading into it parts of the specifications, or of other claims, which the patentees failed to include in it."

(4) *Smith* v. *Snow,* 294 U. S. 1.

In this case the court held (p. 11):

> "While the claims of a patent may incorporate the specifications or drawings by reference . . . and thus limit the patent to the form described in the specifications, . . ."

The court also stated (p. 14):

> "Examination of the claim, in the light both of scientific fact and of the particular form in which the petitioner reduced the claim to practice *as described in the specifications,* makes it plain that the claim does not call for. . . ."

(5) *Cimiotti Unhairing Co.* v. *American Fur Refining Co.,* 198 U. S. 399.

In this case the court said (pp. 413, 414):

> "But in determining infringement we are entitled to look at the practical operation of the machines."

The court also said that (p. 410):

> ". . . the courts may construe the same" (the claims) *"in view of the specifications* and the state of the art, . . ."

(6) *Merrill* v. *Yeomans,* 94 U. S. 568.

In this case the court said (p. 569):

> "The issue thus presented must be decided solely upon a correct construction of the plaintiff's patent, *and the accompanying specifications,* in which, as required by the Act of Congress, he makes the statement of his invention."

The court considered the specification in construing the claims and said at page 571:

> *"But the language in the specifications aids us in construing the claim. . . ."*

(7) *Railroad Co.* v. *Dubois,* 79 U. S. (12 Wall.) 47.

In this case the court, in order to interpret the claim, considered the specification. The court at page 62 stated:

> "The claim *refers to the specification, and that explains both its construction and* its possible use in strengthening the piers."

(8) *Seymour* v. *Osborne,* 78 U. S. (11 Wall.) 516.

In this case the court said at page 547:

> ". . . Where the claim immediately follows the description of the invention *it may be construed in connection with the explanations contained in the specifications,* and *where it contains words referring back to the specifications, it cannot properly be construed in any other way.* . . ."

(9) *White* v. *Dunbar,* 119 U. S. 47.

In this case the court was interpreting the claims of a patent and in order to determine what interpretation should be placed upon the claims, it considered the specification of the patent in detail. The court stated at page 50:

> ". . . *The description of the invention throughout,* specifies a textile fabric as the material to be interposed between the shrimp and metallic can. It is true that the object of the invention is stated to be 'to prevent the article to be preserved from coming in direct contact with the surface of the can.' But the object of an invention is very different from the invention itself. The object may be accomplished in many ways; the invention shows one way."

The court also said in condemning the attempt to construe a claim to cover an invention different from that disclosed in the specification (p. 52):

> "The claim is a statutory requirement, prescribed for the very purpose of making the patentee define what his invention is; and it is unjust to the public, as well as an evasion of the law, to construe it in a manner different from the plain import of its terms."

(10) *Hogg* v. *Emerson,* 52 U. S. (11 How.) 587.

The court in this case in interpreting the claims of the patent in suit considered the specification, and referring to the lower court, said at page 606:

> "The court did right, too, *in holding to the propriety of looking to the whole specification, and also to the drawings, for explanation of anything obscure.*"

(11) *Motion Picture Co.* v. *Universal Film Co.,* 243 U. S. 502.

In this case the court at page 510 stated that one of the long established rules of the court relative to patent law and the construction of patents was:

> "The scope of every patent is limited to the invention described in the claims contained in it, *read in the light of the specification.*"

(12) *Railroad Co.* v. *Mellon,* 104 U. S. 112.

While in this case the court stated that the claims are to be looked at to determine what is covered by the letters patent, it was dealing with a situation in which there was an attempt made to construe the claim broadly to incorporate into it something which was not included in the claim but which was included in the specification. In this connection, the court said at page 118:

> "In view, therefore, of the statute, the practice of the Patent Office, and the decisions of this court, we think that the scope of letters patent should be limited to the invention covered by the claim, *and that though the claim may be illustrated,* it cannot be enlarged by the language used in other parts of the specifications."

The court, in construing the claim of the patent in suit, considered the specification of the patent.

As to the first ground upon which the petitioner invokes the judicial discretion of this court, it should only be necessary to say that everyone recognizes the statutory requirement and legal right of a patentee to confine his patent claims to the part or parts wherein his invention resides, rather than including in his claims the old elements or environment with which his claimed invention may be used.

Neither this proposition, nor the cases cited in support of it, have anything to do with the instant case. In *Rogers* v. *Alemite* (298 U. S. 415), the court held that the patentee had included in his claims various elements which constituted no part of his invention. The same thing was true of *Lincoln* v. *Stewart-Warner* (303 U. S. 545). The pretense of the petitioner is that in the instant case the Court of Appeals held, in effect, that in order to hold the defendant for infringement, Baldner must have included as elements of his claims the hose and the coupler and the lubricant fittings with which the defendant's grease guns were invariably used. This is an absurd and wholly unjustifiable misrepresentation of the language and the substance of the decision of the Court of Appeals. All that the Court of Appeals said relative to the matter of the hose and the coupler and the lubricant fittings, was to emphasize the fact that the defendant's grease gun was not, and could not be, used as a meter or measuring device, and that the presence of the hose and the coupler, etc., in the defndant's device made it impossible to attain such a relationship of pressures as Baldner's claims required of any device coming within their scope and purview. It is absurd and ridiculous to say, as the petitioner does in effect say, that the Court of Appeals held that Baldner should have included the hose and the

coupler and the lubricant fitting as elements of his claimed combination,—because, as a matter of fact, Baldner did not even disclose in his specifications and drawings, either a grease gun or the hose or coupler or lubricant fitting of a lubricating system,—and, as a matter of fact he may never even have heard of such things. Certainly he would not have been permitted to include in his claims any elements which he had not described in his specifications.

As a matter of fact, Baldner did not describe a lubricating system. He did not describe a grease gun. He did not describe either the hose or the coupler or the lubricant fitting of a lubricant system. He could not claim these things. He did not claim them. The Court of Appeals did not say or intimate that he could or should have claimed them.

What the Court of Appeals said was that the defendant's rock crusher grease gun did not incorporate all of those elements which Baldner did include in his several claims. Consequently, there was no infringement.

Summary of the Respondent's Argument in Reply to that of the Petitioner.

There is a temptation to go through the petitioner's petition and brief in detail, pointing out the ingenious subtleties and perversions upon which the argument is carried. But to do so would unwarrantably extend an already long brief in reply.

We should like to have your Honors examine the record to determine that the machine, which on page 30 of its brief, the petitioner says was capable of developing grease pressures reaching 7000 pounds per square inch, was not the Baldner machine at all.

We should like to examine the scores of places wherein the petitioner says in variant language that:

> "Baldner's patent specification, besides showing, describing and claiming his power driven two-stage grease dispensing machine **also** shows and describes a small meter or dial and an electrical switch controlling circuit which may be optionally superimposed upon the grease dispensing machines, in order to indicate or register the total amount of grease dispensed or delivered by the grease dispensing machine" (Petitioner's brief, p. 31),

for the fact is that if any parts of the Baldner device are to be regarded as constituting a "power driven two-stage grease dispensing machine", then those very parts include what Baldner himself repeatedly called his "rotary power driven meter 24" (page 2, line 54). The Baldner patent does not **also** show and describe a small meter.

Petitioner says that "there has been no charge that the defendant-respondent has used the small meter, dial or gauge, or the electrical control circuit which are disclosed in the patent specification." It is, of course, true that the plaintiff-petitioner did not charge that the defendant-respondent had used a dial or a gauge or the electrical control circuit which are disclosed in the patent specification, but the essence of the plaintiff-petitioner's charge was that the small high pressure producing pump of the defendant's grease gun was the ejector which Baldner's specifications and Patent Office arguments so emphatically described as a "rotary meter",—something quite different from an ordinary pump.

But we shall have to content ourselves with a categorical answer to the summary of the petitioner's argument as set forth on page 24 of its brief. In this

summary the petitioner asserts that the decision of the Circuit Court of Appeals was in error, for certain specified reasons:

1. The petitioner alleges that the decision of the Court of Appeals was in error because "the accused grease compressor and the patented, new improved grease compressor are equivalent, element for element." We deny any such equivalency either in whole or part by part.

2. The decision of the Court of Appeals is alleged to have been in error because "the claims in issue are unanticipated and admittedly valid." Neither the Court nor the defendant has admitted any such validity. We have insisted, and the District Court found, that if the claims be misinterpreted in such a way as to read on the defendant's grease gun, then they are invalid because anticipated. The District Court so found and held. The Court of Appeals found it unnecessary to pass upon the question.

3. The petitioner asserts that the Court of Appeals decided that there was no infringement "for the sole reason that the claims are confined to the vital part of the equipment." Such was not at all the decision or the reason for the decision of the Court of Appeals.

4. The petitioner asserts that the Court of Appeals decided that there was no infringement "because and for the sole reason that the claims . . . do not include an old aggregation of a grease compressor, hose coupler and fitting, as sold and used by the defendant-respondent." We deny it. Such was not the sole reason or any of the reasons for the decision of the Circuit Court of Appeals that there was no infringement of any of the four claims in suit of the Baldner patent.

As to the second alleged "conflict" (which is not at all a conflict between decisions of two Circuit Courts of Appeal, but merely an alleged failure of the Seventh Circuit Court of Appeals to apply certain branches of the settled law of patents), the petitioner assumes certain premises:

1. The assumed fact that "the Baldner claims in suit are valid and unrestricted by the prior art." We have sufficiently indicated that this is a wholly untrue and unwarranted assumption.

2. The petitioner assumes as a premise that "the Baldner machine and the accused machine are mechanical equivalents." The defendant urged and the Court found and held that they were not equivalents.

3. The petitioner assumes as a premise that "the claims in suit 'read on' the accused machine, element for element." They do not so "read on" the accused machine. The Court of Appeals so held and pointed out its reasons for so holding.

Upon the basis of these wholly unwarranted premises the petitioner asserts that the Court of Appeals "exonerated the accused 'Rock Crushers' upon the erroneous ground that the 'entire specification' is the measure for the patented invention rather than the claims." We have made it sufficiently clear that such was not at all the ground of the decision of the Court of Appeals.

Upon the basis of these wholly unwarranted premises the petitioner asserts that the Court of Appeals decided "that the patent does not protect from infringement anything other than the 'entire combination' disclosed in the 'entire specification.'" We have made it sufficiently clear that the Court of Appeals did not reach or apply any such conclusion.

Upon the basis of these wholly unwarranted premises, the petitioner asserts that "the Court of Appeals disregarded the claims in suit and took the 'entire specification' as the measure of the patent." We have made it sufficiently clear that such was not the case.

The plain simple fact of the matter is that Baldner finally persuaded the Patent Office to allow him a patent upon an alleged improvement in plastic dispensing and measuring devices in which a measuring meter was an essential ingredient,—included as an element of each of the claims in suit,—and the Court of Appeals found and held that there was no infringement because the defendant's grease gun did not contain any such measuring meter.

We submit that the petition for a writ of certiorari should be denied.

Respectfully,

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In the Supreme Court of the United States

OCTOBER TERM, 1940.

No. 808.

KENNETH S. CLAPP,
Plaintiff-Petitioner,

vs.

STEWART-WARNER CORPORATION,
Defendant-Respondent.

PETITIONER'S REPLY BRIEF.

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PETITIONER'S REPLY BRIEF.

A. ONLY TWO POINTS OF LAW PRESENTED TO THIS COURT.

The petitioner, Kenneth S. Clapp, respectfully redirects your Honors' attention to the two conflicting grounds as set forth in the Petition for Writ of Certiorari. The Seventh Circuit Court of Appeals made its decision of non-infringement upon these two grounds and these two grounds only:

First Ground:

Because the accused "Rock Crushers" are "always *sold and used* with a delivery hose attached, the hose being fitted at its forward end with a coupler by which it is attachable to the lubricant fitting."

This ruling that the "Rock Crushers" escape from the scope of the Baldner claims in suit because the claims do not include the hose, coupler and fitting, is in direct conflict to this Court's decisions in *Rogers vs. Alemite* (298 U. S. 415) and *Lincoln vs. Stewart-Warner* (303 U. S. 545).

The defendant-respondent has failed completely to meet this issue in its Answer Brief.

Second Ground:

Because in the accused "Rock Crushers" "there is *no way of knowing* how many cubic inches of lubricant may be used" as there is no gauge, meter or other counting or indicating mechanism added to the structure of the "Rock Crushers."

This ruling that the "Rock Crushers" avoid the infringement of the patent because they do not include in their structure any means of providing a "way of knowing" or to "tell how much grease" may be used, which additive feature is also disclosed in the "entire specification" of the Baldner patent but which is *not* included in the claims in suit, is in direct conflict with this Court's decisions in *Continental Paper Bag Co. vs. Eastern Paper Bag Co.* (210 U. S. 405); *Leeds and Catlin vs. Victor Talking Machine Co.* (213 U. S. 301); *Altoona Theaters vs. Tri-Ergon Corp.* (294 U. S. 477) and other cases, holding that patent claims rather than the specification measure the scope of the patent.

The defendant-respondent has failed completely to meet this second issue in its Answer Brief.

B. THE BALDNER CLAIMS IN SUIT DO NOT INCLUDE A GAUGE OR METER TO PROVIDE A "WAY OF KNOWING" OR TO "TELL HOW MUCH" GREASE IS DISPENSED DURING A PERIOD OF OPERATION.

Again, example claim 3 reads:

> "3. In an apparatus of the character described, a reservoir, an ejector communicating therewith dividing the discharged material into successive charges of known capacity and conveyor means for supplying the material to the ejector in quantity greater than its capacity whereby said ejector will act to impede the normal flow of the material under influence of the first ejector and will be operated at full capacity to discharge the material in known measured quantity."

This claim reads squarely upon the accused "Rock Crushers." The defendant-respondent has been unable to point out in the claim anything which may be called a gauge or meter to provide a "way of knowing" or to "tell how much" grease is dispensed during a period of operation. This is inevitable because the claim calls for nothing more than that which is found in the accused "Rock Crushers."

The claimed machine and the accused machine have, as defined by claim 3:

1. A reservoir.
2. An ejector (positive-displacement booster or pump of fixed volume and capable of producing 7000 pounds pressure per square inch in the Baldner device and 5000 pounds per square inch in the "Rock Crusher") communicating therewith dividing the discharged material into successive charges of known capacity.
3. Conveyor means (screw conveyor producing an impositive feed) for supplying the material to the positive-displacement ejector in quantity greater than its capacity whereby said positive-displacement ejector will act to impede the normal flow of the material under influence of the first ejector (screw conveyor). The supplying of the grease in quantity greater than the positive-displacement ejector enables the screw conveyor to pack the grease *solid* against the intake orifice of the positive displacement ejector to expel or churn out the air contained in the air pockets or grease. This is the provision which prevents the positive-displacement ejector from becoming "air bound." Accordingly, the positive displacement ejector is always filled with *solid* grease and is operated at *full capacity* or in *known measured quantity* devoid of air pockets. Each ejection stroke delivers a *full* increment of grease.

The "measured quantity" last referred to in the claim is in the *singular* rather than in the plural. There is no

reference in the claim to provide a "way of knowing" or to "tell how much" grease is dispensed during a period of operation. As explained in the Petition for Writ of Certiorari, the Baldner patent specification besides showing and describing his power driven two-stage grease-dispensing machine, as claimed for example in claim 3, also shows and describes a small meter, dial or gauge and an electrical switch-controlling circuit which may be optionally superimposed upon the grease-dispensing machine to provide a "way of knowing" or to "tell how much" grease may be used. The counting meter, dial or gauge is the subject matter of other claims not in suit. There has been no charge that the defendant-respondent has used the counting meter, dial or gauge to provide a "way of knowing" or to "tell how much" grease has been used. The charge of infringement is directed toward the large grease-dispensing machine, *per se*.

Without investigating the claims and obliviously disregarding the content of the claims, the Court of Appeals found a basis for its decision by refusing to use the claims as a measure of the invention to be protected. Instead of following the principle established by the decisions of this Court, the Circuit Court of Appeals took the "entire specification" rather than the claims as the measure of the patent.

C. THE TERMINOLOGY OF THE CIRCUIT COURT OF APPEALS HAS BEEN ADOPTED BY THE PLAINTIFF-PETITIONER.

As it is the decision of the Circuit Court of Appeals of which review and reversal is sought, the particular language used by that Court has been adopted by the plaintiff-petitioner. It is fully apparent from the contents of the opinion of the Court of Appeals that in that Court's language a meter is a counting or indicating mechanism for recording the total amount of grease dispensed during a greasing operation. The Court of Appeals demonstrated

the meaning with which it used the word "meter," by such statements as:

> "There is no meter or gauge of any kind included in the structure (of the Rock Crushers) which is used or usable to measure the quantity of grease discharged, and in lubricating a car there is *no way of knowing* how many cubic inches of lubricant may be used." (R-II 1044.)

> "Appellee was not concerned with the exact amount that it was delivering for the benefit of the purchaser. Its object was to deliver whatever was necessary for greasing the bearings, and no one *could tell how much* that would be. Under these circumstances a meter was not necessary to accomplish appellee's objects, and the accused devices have no such means." (R-II 1045.)

Therefore, the Court of Appeals used the word "meter" in the sense of an instrument for indicating and recording automatically the total quantity measured over a period of time; that is, in the sense of a gauge to provide a "way of knowing" or to "tell how much" grease has been used. This is also apparent from the manner in which the Court interchangeably used the word "meter" and the word "gauge." The context of the opinion by the Court of Appeals makes it very clear that it exculpated the accused "Rock Crushers" from the charge of infringement because they do not include any counting or indicating instrument for recording the total quantity of grease dispensed during a greasing operation. This unwarranted decision was made in the face of the unquestioned fact that the claims in suit do not include nor attempt to include any counting or indicating instrument to provide a "way of knowing" or to "tell how much" grease has been used.

In a different sense (but not in the sense used by the Court of Appeals) the word "meter" is a designation sometimes applied to a positive-displacement pump which, upon each successive ejection stroke, forcibly discharges the *same amount* of grease, provided, of course, that the ejection chamber has been completely filled with solid grease.

In this sense, each ejection delivers a full increment of grease.

The characteristic of discharging the same, full increment of grease upon each successive ejection stroke spells *full capacity*. In this particular sense a meter is a full-capacity pump. The Baldner final ejector and the Rock Crusher final ejector are both full-capacity pumps. Both are interchangeable with each other and they are both meters (in the sense of full capacity). The "full-capacity" nature of the final ejector or pump of the "Rock Crushers" is admitted in the defendant-respondent's advertising literature (R-I 507 to 519; of which excerpts are reproduced as Appendix A of this Brief).

The patent specification signed by Baldner variously refers to his final ejecting mechanism as a booster or auxiliary ejector or pump, and as a "meter" (in the sense of full capacity) for forcibly advancing the grease. Any of these words equally describe the final, positive-displacement ejecting mechanism of both the Baldner and the Rock Crusher machines. The word booster (quoted by Baldner in his specification) is a term which has a definite meaning in the grease dispensing art, and is sufficient, in and of itself, to stamp the final ejecting mechanism of the Baldner patent as a high pressure pump, which under tests in court actually produced 7000 pounds pressure per square inch.

In claim 3, Baldner describes his final ejecting mechanism as an ejector. The Court of Appeals totally disregarded this fact and instead took the "entire specification" as the measure of the patent. The claim 3 does not include nor does it attempt to include any counting or indicating instrument to provide a "way of knowing" or to "tell how much" grease has been used.

The word meter or rotary meter repeatedly printed in bold letters in the defendant-respondent's Answer Brief refers to the final ejecting mechanism in the sense of full capacity, that is in the sense of delivering the same, full in-

crement of grease upon each ejection stroke and not in the sense, as used by the Court of Appeals, to provide a "way of knowing" or to "tell how much" grease has been used. In the Petition for Writ of Certiorari, the plaintiff-petitioner has used the word "meter" in the same terminology and language used by the Court of Appeals in its decision under review. Therefore, the portion of the defendant-respondent's Answer Brief dealing with the word "meter" (used in the sense of a full-capacity pump) particularly where it is printed in bold letters, is irrelevant and immaterial as being inconsistent with the word "meter" (used in a sense of providing a "way of knowing" or to "tell how much" grease has been delivered) as described in the language of the Court of Appeals.

D. THE DEFENDANT-RESPONDENT HAS DEVOTED ITS ANSWER BRIEF TO MATTERS THAT ARE NOT IN ISSUE BEFORE THIS COURT.

The bulk of the defendant-respondent's Answer Brief filed in this Court is comprised of the very same arguments which it urged without avail upon the Seventh Circuit Court of Appeals. The opinion of the Court of Appeals demonstrates that the Court was not satisfied with these arguments as a basis for its decision but rather insisted upon basing its decision on the two grounds which have been shown to be in conflict with the prior decisions of this Court.

In the appeal to the Circuit Court of Appeals the alleged "prior art" was thoroughly briefed and argued. (This "prior art" included the Battenfeld *brick-making* machine of which a partial and inadequate view is shown facing page 16 of the defendant-respondent's Answer Brief. It was demonstrated to the Court of Appeals by briefs and arguments that brick-making machines are from a *non-analogous* art and that the only and *uncontroverted* testimony of record showed many structural and operative differences between the Battenfeld brick-making machine and the Baldner and the Rock Crusher machines and the only

and *uncontroverted* testimony further established that the Battenfeld machine would *not work* to dispense grease. The defendant-respondent for its own purpose has failed to refer to the Record when discussing the Battenfeld brick-making machine.) As a result of the thorough exposure of the alleged "prior art" by the briefs and arguments submitted to it, the Circuit Court of Appeals declined to base its decision upon such "prior art" but instead based its decision *solely* upon the two grounds presented to this Court by the Petition for Writ of Certiorari.

In the appeal to the Circuit Court of Appeals the question of the effect of the file wrapper statements by the solicitor prosecuting the Baldner patent application was thoroughly briefed. (This issue included the portions of the solicitor's statements now quoted in the defendant-respondent's Answer Brief which, however, omits any reference to the Patent Office Examiner's full answer thereto and to the subsequent *abandonment* thereof, and fails to refer to the only testimony of record upon the real nature of the patent prosecution history demonstrating that these statements do not limit the scope of the patent under the controlling decisions.) As a result of the analytical exposition of the true nature and significance of these "file wrapper statements" by the briefs submitted to it, the Circuit Court of Appeals declined to base its decision upon such "file wrapper statements" but instead based its decision *solely* upon the two grounds presented to this Court by the Petition for Writ of Certiorari.

In the appeal to the Circuit Court of Appeals the charge that the Baldner patent was "a mere paper patent" for purposes of construction was thoroughly briefed and considered. (This was briefed even though the charge of "paper patent" had been *expressly withdrawn* by defendant-respondent's counsel in the trial court upon it being shown that the plaintiff-appellant was thwarted in his endeavor to commercially manufacture his embodiment of the

Baldner grease-dispensing machine because of the defendant-respondent's monopoly upon couplers and fittings attachable to the end of the grease hose: R-I 35-36, 86; also reproduced as Appendix B attached to this Brief). As a result of the full revelation of the commercial history of the Baldner patent by the briefs submitted to it, the Circuit Court of Appeals declined to base its decision upon such a charge of "paper patent" but instead based its decision *solely* upon the two grounds presented to this Court by the Petition for Writ of Certiorari.

It is therefore found that the reiterated arguments submitted to this Court by the defendant-respondent's Answer Brief have already been urged before the Court of Appeals and have there been found wanting. The Court of Appeals refused to adopt these now repeated arguments as grounds for its decision but rather determined to base its decision solely upon the two grounds set forth in the Petition for Writ of Certiorari.

E. THE BALDNER PATENT HAS BEEN EXPRESSLY FOUND BY THE CIRCUIT COURT OF APPEALS TO BE ENTITLED TO THE PRESUMPTION WHICH THE ISSUANCE OF THE PATENT BESTOWS UPON IT.

The plaintiff-petitioner has stated in his Petition for Writ of Certiorari and in his supporting Brief that the Seventh Circuit Court of Appeals adjudged the Baldner patent valid and had refused to apply any prior art to anticipate or restrict the claims in suit. This statement has been challenged by the defendant-respondent as a misrepresentation.

The following quoted portion of the opinion by the Seventh Circuit Court of Appeals is submitted for the purpose of an examination of the charge of misrepresentation.

> "Other questions are raised which bear on the question of validity. However, appellee admits no concern in the question of validity, in view of our interpreta-

tion of the patent. While the District Court held the patent was invalid, even if there was infringement, yet, it cited no specific prior art upon which that judgment was based. Under these circumstances we deem it unnecessary to express any opinion on the question of validity, and leave appellant with *the benefit of the presumption which the issuance of the patent bestows upon it.*" (R-II 1046.)

It is again submitted as a solemn representation to this Court that by the above quoted statement the Seventh Circuit Court of Appeals refused to apply any prior art to anticipate or restrict the claims in any degree and *found the patent and the claims in suit to be valid.*

This representation is made by reason of the expressed statement of the Circuit Court of Appeals in its opinion and by reason of the assurance given by the decisions of this Court and of other Courts as to the meaning and legal significance of that statement.

This Court has expressly decided that the presumption which attaches to the issuance of a patent is the presumption of *validity.* That a duly issued patent is *presumed valid* has been repeatedly stated in the decisions of this Court, as for example:

"As this Court said in *Cantrell v. Wallick,* 117 U. S. 689, 695, 696: 'For the grant of letters patent is *prima facie evidence* that the patentee is the first inventor of the device described in the letters patent and of its novelty. *Smith vs. Goodyear Dental Vulcanite Co.,* 93 U. S. 486; *Lehnbeuter v. Holthaus,* 105 U. S. 94.' The issue of the patent is enough to show, until the contrary appears, that all the conditions under which a discovery is patentable in accordance with the statutes have been met. Hence, the burden of proving want of novelty is upon him who avers it. *Walker on Patents,* Section 116. Not only is the burden to make good this defense upon the party setting it up, but his burden is a heavy one, as it has been held that 'every reasonable doubt should be resolved against him.'" *Muxim v. Decker,* 301 U. S. 168, 171.

"A patent regularly issued, and even more obviously a patent issued after a hearing of all the rival claimants, is *presumed to be valid* until the presumption has been overcome by convincing evidence of error. The force of that presumption has found varying expression in this and other courts. Sometimes it is said that in a suit for infringement, when the defense is a prior invention, 'the burden of proof to make good this defense' is 'upon the party setting it up,' and 'every reasonable doubt should be resolved against him.'" *Radio Corp. of America vs. Radio Engineering Laboratories,* 293 U. S. 1, 7.

To the same effect are the cases of:

Cantrell vs. Wallick, 117 U. S. 689, 695;

Morgan vs. Daniels, 153 U. S. 120, 123;

Smith vs. Goodyear, 93 U. S. 486, 498.

That the Seventh Circuit Court of Appeals understood the full import of its words and did expressly adjudge the Baldner patent valid, is shown by other decisions of that Court, for example:

"Want of invention so apparent on the face of the patent as to demand the court's dismissal of a complaint based thereon, even before an answer or hearing on the merits, has on many occasions provoked discussion by courts, with the conclusion that the court's inclination to hold the patent so lacking in invention is generally overcome by *the presumption of validity which attends the issuance of every patent.*"

Gatch Wire vs. Laidlaw, 108 Fed. 2nd 433, 435 (C. C. A. 7).

The same Court recognized that issuance of a patent carries with it the presumption of validity, in the cases of:

Crowder vs. Armour, 105 Fed. 2nd 232, 237 (C. C. A. 7);

Wisconsin Alumni vs. Breon, 85 Fed. 2nd 166, 167 (C. C. A. 7).

Therefore, it may be stated with confidence that the Seventh Circuit Court of Appeals adjudged the Baldner patent to be *valid* when it found it to be entitled to "the presumption which the issuance of the patent bestows upon it." The patent claims, being valid, describe a new and useful invention in the art of grease dispensing, to wit; a two-stage grease-dispensing machine or grease-gun in which an *im*positive-displacement screw-conveyor continuously feeds grease from a reservoir to a positive-displacement intermittent booster or pump positively inter-geared therewith, at a rate-of-feed *greater* than the displacement rate of the booster;—to the end that, upon the intake stroke or movement of the piston, the chamber of the booster is *completely filled* at each and every stroke (instead of becoming "air-bound") and that, upon the discharge stroke or movement of the piston, the discharged grease is ejected from the booster or pump in a *uniform and continuous flow* (instead of spasmodic spluttering with air pockets or instead of ceasing to flow altogether).

CONCLUSION.

This Court is presented with two issues and two issues only. These are the two grounds upon which the Seventh Circuit Court of Appeals based its decision in this case and which are in direct conflict with the decisions of this Court upon the same points. The defendant-respondent in directing its Brief to extraneous issues not before this Court has failed to answer the questions presented by the Petition for Writ of Certiorari.

The plaintiff-petitioner respectfully requests the allowance of his Petition.

Respectfully submitted,

KENNETH S. CLAPP,

By BRUCE B. KROST,

Counsel for Petitioner.

APPENDIX A.

Excerpts from the defendant-respondent's advertising literature (R-I, 507-519) showing the "full capacity" nature of the positive-displacement pump of the "Rock-Crushers," and reproduction of one of the advertisements (R-I, 507).

"A *new feature* in an electric gun, is the helix arm and worm inside the lubricant tank, which *pulls the lubricant into the booster chamber, assuring positive prime and elimination of air pocket trouble.*" (R-I, 507.)

"Worm action also *eliminates air pockets.*"* (R-I, 509.)

"The lubricant is pulled down to the booster chamber by means of a worm." (R-I, 513.)

"It is not necessary to use a great deal of care in loading this gun *to avoid air pockets,* because the helix arm 'K' and the worm 'L' *force the air out of the lubricant before the lubricant is pulled down to the booster chamber.*" (R-I, 513.)

"*Air pockets* are rare in this gun because of the *worm action.*" (R-I, 515.)

"*Air pockets* develop *only* when gun is filled initially or when gun runs empty." (R-I, 519.)

"Delivers approximately *9½ ounces* of fibrous lubricants *per minute.*" (R-I, 507.)

"The control valve is designed to give *either a small delivery* of lubricant at a time *or a continuous flow.*** If only a single small shot of lubricant is desired depress the control lever 'R', Fig. 3, down to the first noticeable stop. *A measured shot of lubricant is then delivered.*" (R-I, 513, 517.)

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* Elimination of air pockets assures the operation of the pump at full capacity.

** Baldner patent (R-II, 683) states that it is an object of the invention "to insure uniform and *continuous* discharge."

ALEMITE ELECTRICALLY OPERATED POWERGUNS

HEAVY DUTY ELECTRICALLY OPERATED POWERGUN

"THE ROCK CRUSHER"

Models 6520 and 6524

Plaintiff's Exhibit 94

Model 6524

This heavy pound capacity Alemite Powergun is powered by a heavy duty Universal Motor that operates on either A. C. or D. C. current.

The RL-40 (Model 6524 or 6520) develops approximately 5000 pounds lubricant pressure, more than enough to open "frozen" bearings. Delivers approximately 3½ ounces of fibrous lubricant per minute.

A new feature is an electric gun, in the bolts arm and worm inside the lubricant tank, which pulls the lubricant into the booster chamber, assuring positive prime and elimination of "pocket" trouble. This feature (only available in Alemite "Rock Crushers") also permits volume delivery of heavy fibrous lubricants.

The RL-40 is equipped with either a 3 wheel platform (large wheels as illustrated) (Model 6530) or hard rubber casters (Model 6530). A convenient handle which permits this gun to be moved about easily is provided. The handle acts as a combination electric cord and lubricant hose rack, making this unit compact, neat and convenient.

The RL-40 is unexcelled for economical and efficient performance in the lubrication of trucks, buses and machines requiring a mixture of fibrous lubricant.

SPECIFICATIONS—6530 and 6524

Lubricant Delivery (Fibrous Lubricant through 10-foot Hose)—Capacity—3½ ounces per minute.

Lubricants Handled—Fibrous, Viscous and Plastic Lubricants easily handled.

Lubricant Capacity—40 pounds.

Pressure Developed—5000 pounds per square inch.

Overall Dimensions—6530—Height 31½ inches, Width 19 inches, Length 39½ inches.

6524—Height 30 inches, Width 24½ inches, Length 35½ inches.

Weight 6530—Net Weight 157 pounds. Shipping Weight 204 pounds.

6524—Net Weight 300 pounds. Shipping Weight 313 pounds.

Equipment—10-foot Volume Hose with Control Valve, Hydraulic Coupling, Push Type Nozzle, Pin Type Adapter, Fan Belted, and 15-foot Electric Cord.

Color—Maroon.

FEATURES OF THE RL-40

1. Greater efficiency.
2. Longer life.
3. Operates on either A. C. or D. C. current.
4. Economical and efficient.
5. Volume delivery of fibrous lubricant.
6. Compact and convenient.
7. Portability with ease.
8. Equipped with "one hand" controlled delivery hydraulic valve.
9. Positive prime.

PRICES

Model 6524—(Illustrated) Electric "Rock Crusher" Complete with Hose (Large Wheels)..... Net Price $250.00

Model 6530—Electric "Rock Crusher" Complete with Hose (Small Hard Rubber Casters)..... Net Price $50.00

APPENDIX B.

Quotations from the Record Showing the Withdrawal in Open Court of the Charge of "Paper Patent."

"Mr. Krost: Q. Tell us what actual physical steps you took thereafter with the invention. Just tell us what you did, where you went, and who you talked to?

A. In order to manufacture this device and place it on the market I had to obtain a license from the Alemite Corporation for the Gullborg pin type couplers and Zerk and Alemite push-type fittings, or otherwise I would be infringing on their patents, even though I had a patent on this device.

Q. Why was it necessary to use an Alemite coupler called the Gullborg-Zerk Coupler?

A. The Bassick Manufacturing Company had a patent monopoly on the couplers which were attached on the end of the hose of the grease gun as well as the attachment on the fittings of the automobile and if I would manufacture a coupling that would fit on those, the fittings of an automobile, I would be infringing on their patent. They had sued several parties on that ground and I was afraid to manufacture it without a license from them.

Q. Did you manufacture and sell the machine—

A. No, sir.

Q. (Continuing.) —in accordance to the new inventions?

A. No, sir.

Q. Why did you not?

Mr. Williams: I think I will object to that as being incompetent.

Mr. Krost: If your Honor please, Mr. Williams made a statement here that this invention had never been put into commercial practice, and it had not been—

Mr. Williams: All right, *I will withdraw it.*

Mr. Krost: We want to show why it was not.

Q. Why haven't you, will you state why you haven't manufactured and sold machines embodying the invention?

A. I was unable to obtain a license from the time it was invented until the present time from the Alemite Corporation for their two couplers which dominated this particular field." (R-I, 35-36.)

"Mr. Krost: I proposed to sh w that the Wayne Company entered into an option, arrangements with Mr. Clapp, by which they were to take a license to manufacture and sell under it and that by reason of their failure to obtain a license to use these Alemite couplers, as was necessary, they failed to exercise the option at the end of the option period, and that was the reason that this device has not been commercially exploited.

The Court: Very well. Go ahead.

Mr. Williams: Well, I think I could agree that that occurred. Mr. Geyer took up with me and our company the matter of getting a license through Mr. Byron, I believe. I don't doubt that it is all as you say. I am willing to *agree* with it." (R-I, 86.)